Supreme Court, U.S.
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No.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1998

WEST PUBLISHING CO. and
WEST PUBLISHING CORPORATION,

Petitioners,

v.

HYPERLAW, INC.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Does an author of a compilation or a derivative work fail to meet the standard for originality set forth in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282 (1991), if the author's contributions are non-trivial and reflect numerous editorial judgments in choosing, from among several possibilities, which facts to select and/or how to arrange the included facts?

2. Does the Copyright Act require that the author of a textual derivative work, based on a pre-existing public domain work, make changes that substantially alter the "substance and flow" of the underlying work?

3. Does a plaintiff, seeking a declaratory judgment denying copyright protection to tens of thousands of different derivative works, meet its burden of proof if it offers into evidence only a statistically insignificant, non-representative sampling of those works?

4. What is the proper standard of review when an appellate court reviews a finding of copyright originality based on undisputed facts?

PARTIES TO THE PROCEEDING

The parties before this Court are those set forth in the caption. Pursuant to Rule 29.6, we advise the Court that West Publishing Company and West Publishing Corporation are wholly owned indirect subsidiaries of The Thomson Corporation, whose shares are publicly traded in Canada and the United Kingdom but not in the United States. West Publishing Company, West Publishing Corporation, and The Thomson Corporation do not have any subsidiaries that are publicly traded.

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West Publishing Company and West Publishing Corporation (collectively, "West") respectfully request that a writ of certiorari be issued to review the opinion and decision of the United States Court of Appeals for the Second Circuit entered in this case.

OPINIONS BELOW

The opinion of the United States District Court for the Southern District of New York (Pet. App. 47a-57a) is reported at 42 U.S.P.Q.2d 1930, 1996 WL 266972 (S.D.N.Y. May 19, 1997). The opinion of the United States Court of Appeals for the Second Circuit (Pet. App. 1a-46a) is reported at 158 F.3d 674. West's petition for rehearing with a suggestion for rehearing *en banc* was denied on December 22, 1998 (Pet. App. 60a-61a).

STATEMENT OF JURISDICTION

This is a declaratory judgment action by HyperLaw, Inc. ("HyperLaw") seeking judgment that it will not infringe West's copyrights in its compilations of case reports by verbatim copying of an unlimited number of the case reports (after redacting West's synopses, headnotes, and key numbers). The district court had jurisdiction under 28 U.S.C. §§ 1331, 1338(a), and 2201. The Court of Appeals had jurisdiction to hear the appeal under 28 U.S.C. § 1291. A timely petition for rehearing with a suggestion for rehearing *en banc* was denied on December 22, 1998, and this petition for a writ of certiorari was filed within 90 days of that date. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1), and Supreme Court Rule 13.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, section 8, clause 8 of the United States Constitution provides that:

> The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Section 101 of the Copyright Act, 17 U.S.C. § 101, provides that:

> "Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.
>
> . . .
>
> A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes a work of authorship.
>
> . . .
>
> A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."

Section 102(a) of the Copyright Act, 17 U.S.C. § 102, provides that:

> Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. . . .

Section 103(a) of the Copyright Act, 17 U.S.C. § 103, provides that:

> The subject matter of copyright as specified by section 102 includes compilations and derivative works. . . .

Section 103(b) of the Copyright Act, 17 U.S.C. § 103, provides that:

> The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. . . .

Section 106(1) of the Copyright Act, 17 U.S.C. § 106, provides that:

> [T]he owner of copyright under this title has the exclusive rights to do and to authorize any of the following:
>
> > (1) to reproduce the copyrighted work in copies or phonorecords;
> >
> > (2) to prepare derivative works based upon the copyrighted work;
> >
> > (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending. . . .

Section 501(a) of the Copyright Act, 17 U.S.C. § 501, provides that:

> Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 120 . . . is an infringer of the copyright. . . .

STATEMENT OF THE CASE

It is now nearly ten years since this Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282 (1991) established a new interpretative framework for the judicial assessment of the copyrightability of compilations and derivative works. This case, in which the Second Circuit has erected unprecedented barriers to copyright protection that do not appear to be authorized by *Feist*, provides an opportunity for the Court to offer much-needed guidance to the lower courts on the application of the *Feist* standards.[1] Confusion as to the proper interpretation of *Feist*, evident throughout the 1990s, has escalated in recent years, and this doctrinal uncertainty now threatens to impede the development of arrangements, compilations, and derivative works by the publishing industry.

Feist eliminated "sweat of the brow" as a basis for extending copyright protection. Finding that the creation of a standard white-pages telephone directory involved no independent choices at all in the selection or arrangement of data, this Court held the directory to be *completely* devoid of "originality" and therefore uncopyrightable. Copyright protection, the Court ruled, should be withheld in those rare instances in which the author's contribution does not reflect even a "modicum of creativity":

> To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, "no matter how crude, humble or obvious" it might be.

499 U.S. at 345, 111 S. Ct. at 1287 (citations omitted).

Feist was an attempt to bring a new coherence to American copyright law by drawing a firm line between mere fact-gathering (unprotectible) and the independent selection, arrangement, or

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1. In a separate petition, West seeks review of the Second Circuit's ruling, in a companion case, that West's copyrighted, original arrangement of reported cases may be copied with impunity by CD-ROM technology.

coordination of facts (protectible). However, *Feist*'s reference to a "modicum of creativity" in connection with originality has introduced a "wild card" into the analysis of compilations and derivative works.[2] Some judges, pointing to this Court's strong emphasis on the minimal nature of the originality requirement, have limited the application of *Feist* to those cases in which selection and arrangement are so mechanical or inevitable as to require no real judgment. Others, perhaps misled by the reference to "creativity" in *Feist*, have raised the bar to a level unintended by either this Court or Congress. The post-*Feist* case law is not merely "split." It is truly splintered, with strongly divergent decisions among and within the Circuits, and an array of unusually vigorous dissenting opinions in leading cases.

In this case, the Second Circuit, ostensibly building on *Feist*, established thresholds for originality that go far beyond *Feist* and are unprecedented in the history of American copyright law. The majority acknowledged that West makes numerous independent judgments in determining how to adapt judicial opinions into West case reports, characterizing one of these judgments as "undeniably creative." Nonetheless, after subjecting West's editorial judgments to a series of rigorous tests, the majority — over a strong dissent by Judge Sweet — concluded that West's work is not "creative" enough to be protected even from verbatim wholesale copying. The majority also ignored the cumulative originality of West's revisions in each report, whereas the statute expressly bases originality in this context on the author's contributions "as a whole." 17 U.S.C. § 101. Finally, the majority also held that West's case reports lack originality as derivative works because they do not "substantially" alter the substance or flow of the underlying opinions. This barrier to copyright protection, again, far exceeds the "modicum" called for in *Feist*.

---

2. Although the Court's intentions probably fell short of the broad language it employed, Feist's repeated references to creativity as part of the originality standard, and to the standard's constitutional foundation, have unavoidably introduced a wild card into the question of copyright protection for all forms of data collections. . . .

1 Paul Goldstein, COPYRIGHT § 2.2.1 (1998). *See also* discussion at pp. 15-22, *infra*.

Guidance from this Court, which has never directly addressed the originality requirement for derivative works, is needed to bring order out of the chaos that has followed *Feist*. The need for direction on these important federal questions is heightened by the increasing value — in this era of information "overload" — of efforts to make information manageable through selection, arrangement, revision, adaptation, and annotation. Contrary to Congress' intent in providing for the separate copyrightability of both compilations and derivative works, the Second Circuit's decision dangerously underprotects works involving the selection, arrangement, and coordination of facts. Given the Second Circuit's longstanding prominence and influence in the field of copyright, this decision significantly deepens the uncertainty surrounding the interpretation of *Feist* — and, if allowed to stand as precedential authority, will surely provide a strong disincentive for the creation of compilations and derivative works.

A. The Editorial Enhancements at Issue

In this action, Hyperlaw seeks a declaration that it may copy — verbatim — hundreds of thousands of unidentified case reports from thousands of West's volumes in the *Supreme Court Reporter* and *Federal Reporter* series. It is undisputed that copyright protects certain components of the reports. However, Hyperlaw — which bases this declaratory judgment action on an indistinctly described, hypothetical product — asserts that, once West's syllabi, headnotes, and key numbers are redacted, copyright law does not bar the copying, for purposes of resale, of every word of an unlimited number of West case reports.[3]

At trial, the uncontested evidence demonstrated that West's adaptation and organization of public domain judicial opinions ("Opinions") for publication as case reports involves revisions and additions — wholly apart from syllabi, headnotes, and key numbers — based on independent editorial judgments, and that these

3. West has never objected to the copying, even by competitors, of individual case reports. It is only the threat of wholesale copying of reports by a "free-riding" competitor that compels West to assert and defend its entitlement to copyright protection.

judgments are subject to continual reassessment and case-by-case variation.[4] The bulk of West's editorial work falls into the following categories:

(1) *Updating, revision, and expansion of the citations in Opinions, and the addition of citations when none exist in the Opinions.* West decides when to add parallel citations, and which citations to add.[5] West also decides when to delete a citation in an Opinion and substitute a more useful, current, or accurate "alternative citation."[6] When an Opinion refers to a case by name, but provides no citation, West will independently add its own citation — unless the case appears on West's "Popular Name Listing," a subjective list of cases created and periodically updated

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4. The facts as to West's editorial work are supported by extensive trial testimony and voluminous trial exhibits and were not questioned by the lower courts.

5. For example, West: (i) expands all Supreme Court case citations to include references to *Supreme Court Reporter* and *Lawyer's Edition* as well as *U.S. Reports* — a choice that is different from that of other publishers and contrary to the explicit Bluebook rule; (ii) adds official state court citations, even when the Bluebook directs otherwise; (iii) decides when to add a Westlaw citation to citations to looseleaf, specialized, or electronic reporters, or slip opinions; (iv) decides when to provide both a LEXIS citation *and* a Westlaw citation; (iv) decides when, and how, to add statute parallel citations; and (v) decides when to add early reporter citations when decisions that pre-date West reporters are cited.

6. For example, West sometimes, but not always, decides to replace (i) electronic or periodical citations with more permanent or accessible citations; (ii) citations to slip opinions or unpublished memoranda with more useful citations; (iii) citations to certain publications with citations to sources that are more widely accepted and/or more likely to be permanently available. Also, if an Opinion includes citations that are outdated, West selectively substitutes up-to-date citations under certain circumstances. For example, West will delete a citation indicating that a petition for certiorari has been filed, and will substitute more up-to-date information, but only if the petition had been acted upon as of the day of the opinion.

by West's editors.[7] As the notes to this paragraph indicate, many of these editorial judgments are substantive and subjective in character, reflecting West's evaluation of its readers' needs and of the relative usefulness — at any point in time — of various citation sources. *See* 158 F.3d at 685 and 691, Pet. App. 25a-30a and 41a.

(2) *The addition of new material, created and/or compiled by West, reflecting subsequent case developments.* When a post-decision order is issued, West independently decides whether, and how, to revise the case report and/or the Opinion to reflect the new development. Depending on the importance of the subsequent development, West may: (i) not report the order at all; (ii) report the subsequent action only in a "file line" written by a West editor who has evaluated the new order; (iii) report the subsequent action only in a table listing; (iv) incorporate the order into the Opinion to create a "combine" in one of several ways, and also create an appropriate file line;[8] (v) publish the order separately and add a cross-reference to an earlier published report; or (vi) completely republish an earlier published report, with appropriate revisions and additions, to reflect the subsequent development.[9] *See* 158 F.3d at 684, Pet. App. 22a-23a.

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7. West also revises case names in citations to conform them with West's case-titling and corrects any errors or omissions in citations (generally without court involvement, pursuant to West's independent editorial direction). When an Opinion cites a case or statute for a specific rule or fact but does not provide a textual location, West's attorney editors expand these "partial citations," on a case-by-case basis, reading both the Opinion and the cited source to determine whether a specific page reference can, and should, be added.

8. With amending orders, for example, West decides whether: (i) merely to make the changes indicated in the order; or (ii) to incorporate the changes and also publish, following the modified opinion, the order itself (which may include explanatory material and/or a dissenting view), in whole or part.

9. These decisions are based on West's evaluation of the importance of a subsequent order and the potential for confusion. (For example, has the prior opinion been in circulation so long that republication is needed

(Cont'd)

(3) *The addition to Opinions — tens of thousands of which contain no information about attorneys — of attorney-related data selected and compiled by West.* For *Supreme Court Reporter*, West adds to the Opinions, which contain no attorney data, by providing summaries of: (i) the names of arguing counsel (but no other attorneys); and (ii) the city and state of practice (but no other data) for each attorney. Many other publishers of Supreme Court decisions include no attorney data. When other Supreme Court case reports do include attorney data, the publishers — *e.g.*, U. S. Law Week and Florida Law Weekly Federal — make editorial choices entirely different from West's, and from each other. For *Federal Reporter*, West creates summaries of attorney data when the Opinions do not contain any data, and it revises and expands the attorney information that is contained in Opinions from some Circuits.[10] *See* 158 F.3d at 683-84, Pet. App. 20a-21a.

(4) *Revision, editing, and reorganization of the procedural data in Opinions to render them more readable and useful.* West edits the courts' captions for readability and concision, and many captions — generally, those that are long or complex, or both — undergo extensive abridgement, revision, and reorganization. West also revises and rearranges the wording and placement of "court lines" and "date lines" to conform them to West's chosen expression.[11]

(Cont'd)

to avoid confusion?) Decisions as to when, where, and how the material in the subsequent order should be expressed are made solely by West, and do not depend on whether, and how, the court itself decides to republish the opinion.

10. In general, West selects the following data — not the same selection chosen for *Supreme Court Reporter* — for *Federal Reporter* summaries: (a) names of briefing, as well as arguing, attorneys; (b) specification of each attorney's role; and (c) cities of practice (but no address or telephone data), law firm affiliations, and agency titles.

11. When captions involve duplication of parties or multiple actions, West reorganizes the data to create what it believes to be a more useful caption. West also uniformly includes both argument and decision dates,

(Cont'd)

B. The District Court's Decision

The district court issued a sweeping declaratory judgment that West's work in annotating, revising, and adapting the Opinions at issue represents, in all cases, an insufficient "creative effort" to warrant copyright protection. 42 U.S.P.Q. 2d at 1932, Pet. App. 48a. The court based this judgment on findings, *inter alia*, that West's editorial "options are limited" and that "the selections made tend to conform to the standard of the legal profession. . . ." *Id.* at 1934, Pet. App. 54a, 55a.

At the same time, however, the district court described West's addition of parallel citations and replacement of court citations with alternative citations as the "most significant additions West makes to the opinions . . . ." 42 U.S.P.Q. 2d at 1934, Pet. App. 55a. Furthermore, the court acknowledged that in at least some instances West's decisions are *not* "mechanical" and involve "a judgment as to which of a number of equally accessible sources should be cited."[12] Similarly, with respect to West's selective addition of "file lines," the court confined its finding of insufficient originality to "most instances." *Id.* at 1933, Pet. App. 53a. Also, the court acknowledged, with respect to the summaries of attorney data that West creates or revises, that "West clearly makes an editorial judgment as to which attorneys' names to publish and whether to add the city of practice . . . ." *Id.* at 1934, Pet. App. 54a.[13]

(Cont'd)
adding missing information and revising the data in Opinions to conform to West's choices of expression. For example, some courts use "filed" to indicate the decision date; West changes this, since some readers might read "filed" to mean the appeal's filing date.

12. *See* 42 U.S.P.Q. 2d at 1934, Pet. App. 55a (choice of parallel citations is "basically mechanical" in "most instances").

13. The district court's application of a higher standard than the *Feist* standard was at least partially attributable to the court's mistaken impression that copyright protection for the original material in West's reports raises special "policy considerations": "[I]t seems unfair to say that West can preclude anyone from copying what is basically a government document." 42 U.S.P.Q. 2d at 1932, Pet. App. 49a. In fact, the public's

(Cont'd)

C. The Court of Appeals' Decision

The Court of Appeals' majority opinion affirmed the district court's finding that there is no protection, even from verbatim copying, for any of West's work in transforming Opinions into West's *Supreme Court Reporter* and *Federal Reporter* case reports. In assessing the "originality" of West's work, the majority acknowledged *Feist* as the primary authority but imposed a high-threshold, multi-part originality standard. The majority also set forth an unprecedented originality test for derivative works, requiring "substantial" alteration of the "substance and flow" of the underlying public domain work. 158 F.3d at 689, Pet. App. 37a. Judge Sweet's dissent noted that the standards imposed by the majority demand "significantly more" and "far more" than required by *Feist* and other precedents. *Id.* at 690, Pet. App. 38a.

REASONS FOR GRANTING THE WRIT

I.

THE PETITION SHOULD BE GRANTED BECAUSE THE SECOND CIRCUIT HAS ERECTED UNPRECEDENTED BARRIERS TO COPYRIGHT PROTECTION THAT CONFLICT WITH THE *FEIST* STANDARD

The majority did *not* hold that West exercises no independent judgments, or makes the same choices made by virtually all other publishers, or makes only "mechanical" choices. No such finding is conceivable, given the undisputed evidence that: (i) West's case reports differ in substantive ways from public domain opinions and reports of other publishers; and (ii) the expression in West's case reports is the result of dozens of independent, often subjective editorial choices. As Judge Sweet emphasized throughout his

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unfettered access to public domain opinions is beyond dispute, particularly since the advent of the Internet. There is, in any event, no statutory basis for a different originality standard for works based on government documents. (Tellingly, the district court mischaracterized West's compilations as "the official reports" in an earlier proceeding in this case. 41 U.S.P.Q. 2d 1321, 1330.)

dissent, West's editorial additions and revisions in the case reports at issue involve "substantive, editorial choices" that "express thought and are not inevitable." 158 F.3d at 691, Pet. App. 41a.

Instead, the majority subjected West's editorial judgments to a series of tests that are inconsistent with *Feist* and undermine Congress' longstanding decision to extend copyright protection to compilations and derivative works. 17 U.S.C. § 103. According to the majority, independent choices are insufficiently "original" unless they: (i) involve *more than three* options; *and* (ii) are "non-obvious."[14] Each of these tests imposes a more demanding standard than that prescribed by this Court in *Feist*. To require that editorial choices meet *both* tests is to erect a high hurdle — one that is a complete barrier to even extremely thin copyright protection — that is dramatically at odds with *Feist*'s "extremely low" threshold. Indeed, the majority's multi-part test invites violation of this Court's longstanding ruling, in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251, 23 S. Ct. 298, 300 (1903), that neither the courts nor the Copyright Office are to judge the quality of a work's originality.

The requirement that editorial choices be "non-obvious" and not "typical"[15] ignores *Feist*'s explicit suggestion that "obvious" or "humble" expressions of independent judgment will satisfy the originality requirement. Applying this high-threshold test, the majority erroneously negated the originality of West's expression that results from decisions that are simply: (i) consistent with general principles of legal reference (but undeniably subjective in their particulars); or (ii) logically responsive to the preferences, as evaluated by West, of its readers.[16]

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14. *See, e.g.*, 158 F.3d at 682, Pet. App. 17a (requiring "non-obvious choices from among more than a few options" and stating, "[s]election from among two or three options" is "insufficient").

15. One indicator of the majority's ratcheting up of the protection threshold is its consistent use of the term "typical," rather than *Feist*'s language, "entirely typical." *See, e.g.*, 158 F.3d at 677, 685, 687, 688, Pet. App. 26a, 31a, 32a.

16. The majority certainly did not suggest that other publishers make the same citation-revision choices as West. Nor did the court find that the (Cont'd)

Moreover, the majority clearly engaged in the kind of qualitative appraisal barred by *Bleistein* when it found insufficient originality merely because two particular judges shared West's opinion of what constitutes the best editorial choice. For example, the majority found West's selective updating of citations devoid of originality because "West's decision to insert a citation to the denial of certiorari only when the denial pre-dated the opinion is necessary to avoid anachronism. . . ." 158 F.3d at 686, Pet. App. 29a. In fact, of course, the decision is only "necessary" if one shares the highly subjective opinion that it is more important to avoid anachronism than to provide the most up-to-date information — *i.e.*, whether a case cited in an opinion has been granted or denied certiorari. Moreover, other publishers provide no updating at all, a third option that is also completely viable. Nothing "dictates" West's choice among these options; the choice is clearly anything but "inevitable."[17]

In sum, the majority, misreading *Feist*, assumed that it could negate West's originality even though West's reports contain expression resulting from subjective editorial judgments.[18] It is plain

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(Cont'd)
Bluebook prescribes West's revision choices. At most, the majority merely found that a few of West's choices seem somewhat common or familiar. As the dissent noted, this impression may well be the result of West's longtime success and the familiarity of its works to legal researchers — neither of which is a basis for eviscerating copyright protection. 158 F.3d at 692-93, Pet. App. 45a-46a.

17. The majority conceded that West's subjective decision to allow informal references (without full citation) to certain "popular" cases is an "undeniably creative" practice but negates this originality as well by speculating that any copying of these references would "seem[] to be de minimis. . . ." 158 F.3d at 674 n.10, Pet. App. 30a-31a n.10. This, of course, ignores the systematic character and cumulative effective of the taking.

18. For example, West subjectively evaluates 30 publications as being either: (i) not useful enough to be retained if a West Reporter citation can be substituted; or (ii) so useful that they are always retained, even if a West Reporter citation is available. The majority acknowledged that some *but not all* of the citations replaced by West are from daily or weekly journals. The majority suggested no reason, other than highly subjective evaluation, why West would delete certain permanent-book citations and not delete others. 158 F.3d at 674 n.8, Pet. App. 26a-28a n.8.

— and the majority did not find otherwise — that West could make dozens of different choices, in preparing a single case report for publication, without departing from some "industry standard," breaking the law, or even looking foolish, leading to entirely different expressive content. As Judge Sweet concluded:

> West makes dozens of multi-part, variable judgments, and there is no evidence that any of West's choices are commonplace, "practically inevitable," dictated by law, or that they follow any external guidelines. On the contrary, the record demonstrates that West makes a number of substantive, editorial choices — without court direction or approval — in determining the content and expression of its case reports. West's judgments involve assessments of "readability," clarity, completeness, availability (present and future) of sources, and other subjective considerations related to making the reports more useful.

158 F.3d at 691, Pet. App. 41a. Yet the majority took the position that *Feist* authorizes judicial denial of copyright protection when the court finds some but not enough originality to satisfy its own subjective standard.[19]

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19. The majority also denied copyright protection because "a competitor would have difficulty creating a useful case report without using many of the same citations." 158 F.3d at 688, Pet. App. 32a. There is no support in the record for this conclusion; as the dissent noted, opinions can, and are, published "with a variety of citation combinations and other facts either included or not." *Id.* at 692, Pet. App. 45a. Moreover, the majority's view represents a *de facto* misapplication of the merger doctrine and a serious misapprehension of the idea/expression dichotomy. West does not secure a monopoly in any ideas by protecting the highly specific, subjectively determined expression in West's case reports. In any event, this case concerns only the verbatim copying of West's case reports, through computer scanning. "The copyright granted West is thin, but it is sufficient to protect against the verbatim digital copying proposed by Hyperlaw. . . ." *Id.* Indeed, under *Feist*, the way to prevent the monopolization of factual data is not to erect barriers to copyrightability but to restrict the extent of protection given these works.

The majority also ruled that West's reports, as derivative works, are insufficiently original because West's revisions and additions do not substantially alter the "substance and flow" of the preexisting Opinions. Moreover, the majority asserted that West's various revisions in a single case report are not collectively protectible because the "whole does not disclose or express an overall creative insight or purpose . . . ." 158 F.3d at 688, Pet. App. 33a. These requirements clearly erect a high originality requirement that is inconsistent with *Feist,* which emphasizes that "the requisite level of creativity is extremely low" and that "[t]he vast majority of works make the grade quite easily." *Feist*, 499 U.S. at 345. This standard, which would deny protection to myriad derivative works that leave intact the "substance and flow" of the existing work, clearly conflicts with the statute's intent and purpose, as does the majority's view that the aggregate originality of an editor's contributions (selection, arrangement, revision, annotation, coordination) should be ignored when the court discerns no "overall creative insight or purpose."

II.

THE PETITION SHOULD BE GRANTED BECAUSE JUDICIAL CONFUSION REGARDING *FEIST* HAS LED TO INCONSISTENT TREATMENT OF, AND UNDERPROTECTION FOR, COMPILATIONS AND DERIVATIVE WORKS

The Second Circuit's decision in this case is not a singular aberration. On the contrary, although the majority opinion may go further afield than any other decision in overburdening *Feist*'s originality standard, it reflects the confused and conflicted state of the law on this subject. Indeed, authors of fact-based works have never faced such uncertainty as to whether their efforts will be afforded copyright protection. At this critical moment in the history of data-intensive publishing, the Second Circuit's ruling — which implicates, in fundamental ways, the Copyright Act's originality requirement for both compilations and derivative works — presents the Court with an ideal framework to revisit *Feist* and address the precedential instability presently confronting judges, publishers, and authors.

As one commentator noted soon after the decision in *Feist*:

> In holding the white pages directory not copyrightable, the Court employed terms that evoke the patent law standards for protectibility. The Court's word choice might best be viewed as rhetorical excess; it should not prompt lower courts to infer that to be deemed "original" a compilation must now be novel and nonobvious. Were Feist so interpreted, then the Court would not only have eliminated the more commodious "sweat" standard of protection, it would also have initiated a different dual copyright system, requiring compilations to meet a higher standard of authorship than is imposed on other kinds of works.[20]

In fact, the lower courts have drawn divergent inferences from the Court's language in *Feist*. The opinion in *Feist* does refer to "creativity" — a word that does not appear in the statute, and hardly figures at all in prior copyright jurisprudence.[21] Yet the

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20. Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection Of Works Of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 343 (1992).

21. *See* William S. Strong, *Database Protection After Feist v. Rural Telephone Co.*, 42 J. COPYRIGHT SOC'Y U.S.A. 39, 43 (1994). Indeed, the Act's legislative history indicates that the drafters "assiduously avoided including 'creativity' as a component of copyrightability." Russ VerSteeg, *Sparks in the Tinderbox: Feist, "Creativity," and the Legislative History of the 1976 Copyright Act*, 56 U. PITT. L. REV. 549, 552 (1995); *see also* 1 William F. Patry, COPYRIGHT LAW AND PRACTICE 145-48 (1994).

> The [statute's] phrase "original works of authorship," which is purposely left undefined, is intended to incorporate without change the standard of originality established by the courts under the present copyright statute. This standard does not include requirements of novelty, ingenuity, or esthetic merit, and there is no intention to enlarge the standard of copyright protection to require them.

H.R. REP. No. 94-1476, at 51, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664.

opinion repeatedly emphasizes the "minimal" and "extremely low" nature of the originality threshold. The result, as has been widely noted, is judicial confusion as to what a "modicum of creativity" entails; and whether, or how, to apply *Feist* to works that demonstrate more originality than a white-pages telephone directory.[22]

Most strikingly, the "Eleventh Circuit and the Second Circuit have split in their interpretation of Feist."[23] In all post-*Feist* cases except this one, the Second Circuit has applied *Feist* cautiously, keeping in mind its particular facts, the Court's explicit emphasis on the "minimal" originality requirement, and the fundamental purpose of the statute.[24] In *CCC Information Services, Inc. v.*

22. *See, e.g.*, Michelle R. Silverstein, *The Copyrightability of Factual Compilations: An Interpretation Of Feist Through Cases Of Maps And Numbers*, 1996 ANN. SURV. AM. L. 147, 161-62 (1996) ("While the Court was specific about what must be evaluated for a compilation copyright, just how much creativity is needed or exactly what qualifies as 'creative' was never made sufficiently clear. . . . Because of this lack of specificity regarding the meaning of creativity, subsequent courts have been uncertain as to how to apply the Supreme Court's ruling."); Leah Sherry, *Science Based Standards For The Uniform Global Protection Of Intellectual Property: The Case Of Logic Functions Expressions*, 26 CAL. W. INT'L L.J. 335, 342 (1996) (" 'Confusion' is the best description of the state of post-Feist copyright protection "); Goldstein, *supra*, at § 2.2.1 (Court "offered few clues as to what it meant by 'creativity,' and, indeed, whether the requirement is quantitative or qualitative.").

23. Susan H. Nycum, *Protection Of Electronic Databases*, 14 No. 8 COMPUTER LAW. 12, 14 (1997); *see also* Ethan R. York, *Warren Publishing, Inc. v. Microdos Data Corp.: Continuing The Stable Uncertainty Of Copyright In Factual Compilations*, 74 NOTRE DAME L. REV. 565, 588 (1999).

24. Despite the split of authority within the Second Circuit created by the decision below, West's petition for a rehearing *en banc* was denied. This denial is consistent with the circuit's longstanding policy of denying virtually all such petitions (only one was granted in all of 1998) and leaving the resolution of important federal questions to this Court. *See* Jon Newman, *In Banc Practice in the Second Circuit, 1989-93*, 60 BROOK. L. REV. 491 (1994); Jon Newman, *In Banc Practice in the Second Circuit: The Virtues of Restraint*, 50 BROOK. L. REV. 365, 383 (1984).

Maclean Hunter Market Reports, Inc., 44 F.3d 61 (2d Cir. 1994), *cert. denied*, 516 U.S. 817 (1995), Judge Leval analyzed *Feist*, emphasizing the dangers of reading the decision as anything more than a rejection of protection based solely on "sweat of the brow." In words equally applicable to this case, he wrote:

> The Court repeatedly stressed that the required level of originality is minimal, and that most compilations, merely by exercising some independent choice in the coordination, selection, or arrangement of data, will pass the test. The telephone directory failed because it was found to be *completely* devoid of originality. . . .
>
> The thrust of the Supreme Court's ruling in *Feist* was not to erect a high barrier of originality requirement. It was rather to specify, rejecting the strain of lower court rulings that sought to base protection on the "sweat of the brow," that *some* originality is essential to protection of authorship, and that the protection afforded extends only to those original elements.[25] Because the protection is so limited, there is no reason under the policies of the copyright law to demand a high degree of originality. To the contrary, such a requirement would be counterproductive. The policy embodied into law is to encourage authors to publish innovations for the common good — not to threaten them with loss of their livelihood if their works of authorship are found insufficiently imaginative.

Id. at 65, 66 (emphasis in original). Judge Leval also warned that originality is not negated by logical choices that respond to the "needs of the market." To the contrary, "the use of logic to solve the problems of how best to present the information being compiled is independent creation." *Id.* at 67.

The other leading post-*Feist* Second Circuit decisions are to the same effect. In *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991), the court described

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25. *See also* Patry, *supra*, at 199-200 ("The key factor is the exercise of *some* editorial judgment in the selection of data.") (emphasis added).

the minimal level of editorial judgment required by *Feist* as "de minimis thought." *Id.* at 514. In *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991), the court emphasized that *Feist* described the "narrow category" of uncopyrightable works as those in which the " 'selection and arrangement of facts [is] so mechanical or routine as to require no creativity whatsoever.' " *Id.* at 704, *quoting Feist*, 499 U.S. at 362, 111 S. Ct. at 1296.[26]

By contrast, the Eleventh Circuit has taken the position that *Feist* authorizes the denial of copyright protection — based on subjective judicial standards — to expression that is the result of independent editorial judgment. While the Second Circuit extended thin copyright protection to a yellow-pages directory in *Key Publications*, the Eleventh Circuit — in an *en banc* reversal of a circuit panel decision — denied any protection to the yellow-pages directory at issue in *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 999 F.2d 1436 (11th Cir. 1993) (en banc), *cert. denied*, 510 U.S. 1101 (1994). As one commentator has observed, the "Eleventh Circuit's approach directly contradicts Key Publications."[27] This inconsistency is further demonstrated by the fact that the Eleventh Circuit's first decision in the case — which found the work copyrightable — was cited by other Courts of Appeal as an exemplary application of *Feist*. *See, e.g., Atari Games Corp. v. Oman*, 979 F.2d 242, 246 (D.C. Cir. 1992); *Atari Games Corp. v. Nintendo of Am., Inc.*, 975 F.2d 832, 840 (Fed. Cir. 1992).

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26. Indeed, prior to this case, the Second Circuit applied *Feist* to deny copyright protection to a textual work only once, and that case, *Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc.*, 936 F.2d 671 (2d Cir. 1991), exemplifies the rare situation in which "the creative spark is so utterly lacking as to be 'virtually nonexistent.' " *CCC*, 44 F.3d at 67, *citing Feist*, 499 U.S. at 359, 111 S. Ct. at 1295. In *Victor Lalli*, the plaintiff chart publisher made no independent selection or arrangement at all, having adopted "the exact same format" as every other publisher with "no opportunity for variation." *Id.* at 672-73.

27. Ethan L. Wood, *Copyrighting the Yellow Pages: Finding Originality in Factual Compilations*, 78 MINN. L. REV. 1319, 1335 (1994).

More recently, in another *en banc* ruling, a majority of the Eleventh Circuit found a directory of cable television systems to be uncopyrightable, despite the fact that the publisher made a selection and arrangement of facts that departed from previous compilations. *Warren Pub., Inc. v. Microdos Data Corp.*, 115 F.3d 1509 (11th Cir.) (en banc), *cert. denied*, 118 S. Ct. 397 (1997). Yet the dissenting judges found *Feist* to be no obstacle to protection: "Warren's selection of data is original, creative and useful. To suggest it is the only conceivable useful way [like the white pages in *Feist*] is astonishing." *Id.* at 1530 (Godbold, J., dissenting). As one commentator states:

> These elements of selection, coordination, and arrangement far exceed the *Feist* minimum threshold of originality. The majority's opinion is as baffling as it is contrary to the law and the facts.

Patry, *supra*, at 18 (1998 Supp.).[28]

Thus, the circuits are not only split but also internally divided.[29] The Eleventh Circuit has long been in "turmoil," with

28. *See also* York, *supra*, 74 NOTRE DAME L. REV. 565, 588: "What makes the Warren decision so perplexing is the way the Eleventh Circuit so heavily relied on Feist in reaching its decision, notwithstanding Feist's contrary proclamations."

29. Similarly, courts of the Seventh Circuit, like the Eleventh (and, now, the Second), have used *Feist* to deny copyrightability to works that almost certainly would be protected by other federal courts. In *Sassafras Enterprises, Inc. v. Roshco, Inc.*, 889 F. Supp. 343, 346-47 (N.D. Ill. 1995), the court found insufficient originality in a 15-page booklet containing recipes and directions for the care of a pizza stone because "the effort was really compelled by the realities of the marketplace," and the "requisite level of skill and discretion" was missing; a "rather surprising" decision, according to one distinguished commentator. Patry, *supra*, at 255 n.588 (1998 Supp.). In sharp contrast are decisions stressing the minimal nature of the *Feist* standard — *e.g.*, *Atari Games Corp. v. Oman*, *supra*, 979 F.2d at 247 (rejecting attempt to "ratchet" up the protection threshold beyond *Feist*'s "minimal creative spark"); *Mason v. Montgomery Data, Inc.*, 967 F.2d 135 (5th Cir. 1992) (sufficient originality because choices "resulted in independent expression").

"blistering" dissents in *BellSouth* and *Warren*.[30] Now the Second Circuit is in turmoil as well. Few readers of *Key Publications* or *CCC* (among the most widely cited post-*Feist* decisions) could anticipate that the same Court of Appeals would issue the rulings in this case. Courts around the country no longer can look to the Second Circuit for a consistent view of *Feist*.

Inevitably, and completely contrary to Congress' statutory intent, this doctrinal uncertainty will discourage the creation of new compilations and derivative works at a time when works of this kind are particularly needed to select, organize, and present vast quantities and types of data now available in electronic formats. Even before the decisions in this case and in *Warren* were issued, commentators warned that confusion as to *Feist*'s parameters constituted a disincentive to the creation of new works. Typical are the following excerpts, both published in 1994:

> The Feist decision . . . has led to different interpretations of copyright protection for . . . factual compilations. Courts have applied inconsistent standards when evaluating copyright protection for yellow pages directories. Clarifying the appropriate standard of protection is important not only to the yellow pages industry . . . but also to other industries that produce factual compilations, particularly the computer database industry.[31]

> At present, the scope of the Feist rule remains unclear. The muddled state of copyright law after Feist regarding the protection afforded databases provides uncertainty as to future challenges to the usurpation of database materials. It especially bodes ill for the emerging world of electronic databases. Because the Supreme Court has

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30. 1 Melville B. Nimmer & David Nimmer, NIMMER ON COPYRIGHT, § 3.04 n.64 (1998). *See also* Wood, *supra*, 78 MINN. L. REV. at 1344 n.8 ("The history of the BellSouth case provides a good illustration of the confusion that Feist has engendered").

31. Wood, *supra*, 78 MINN. L. REV. at 1320.

> not had an opportunity to revisit the creative originality requirement, it is impossible to state with any degree of certainty the amount of creative originality that would satisfy the requirements of Feist. . . . Hence, the Feist decision will continue to cast its shadow over works that are on the borderline of copyrightability unless the rule is clarified or excised. As a consequence, it is important for the Court to revisit Feist . . . .[32]

Since 1994, as the electronic publishing industry has become increasingly vital to the American economy, the confusion as to protectibility for compilations has become even greater.

Indeed, the Second Circuit's subjective application of a test for "non-obviousness" is inconsistent not only with *Feist* but with this Court's rejection, in *Bleistein*, of any form of an artistic merit test as a regulator of copyright protection. Given that independent creation is not infringement under copyright law (in contrast to patent law), a merit test is unnecessary; it is also difficult to administer and will inevitably deny protection to works that prove valuable. In the American tradition of copyright law, which has served us well, courts are barred from making value judgments about the relative quality or creativity of an author's work.

In this case, and others like it, judges are turning their backs on that tradition and effectively making merit decisions about the copyrightability of works of expression. Thus, these cases raise a public policy question of enormous proportion under the Copyright Act, and only this Court can eliminate the confusion.[33]

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32. Anant S. Narayanan, *Standards Of Protection For Databases In The European Community And The United States: Feist And The Myth Of Creative Originality*, 27 GEO. WASH. J. INT'L. L. & ECON. 457, 469 (1994).

33. This case, unlike *Warren* and *BellSouth*, involves a wide array of different kinds of editorial contributions and decisions, including, *inter alia*, category selection, choices of data within categories, arrangement and reorganization of data, abridgement, and the creation of original text to report on subsequent case developments. Thus, this Court's analysis of the Court of Appeals' decision would provide unusually valuable guidance to the lower courts.

III.

THE PETITION SHOULD BE GRANTED BECAUSE CONFUSION CONCERNING THE ORIGINALITY STANDARD FOR DERIVATIVE WORKS POSES A SERIOUS DISINCENTIVE TO THE CREATION OF NEW WORKS

The Second Circuit's decision also seriously exacerbates the uncertainty in the lower courts' use of an originality requirement for derivative works — a subject that has never been addressed by this Court. The majority denied derivative work protection to West's adaptations of public domain Opinions because West's contributions do not result in "substantial changes to the substance and flow" of the preexisting works. 158 F.3d at 689, Pet. App. 37a.[34] This unprecedented standard is inconsistent not only with *Feist* but also with the longstanding originality test for derivative works enunciated by the Second Circuit itself and adopted by many courts:

> [A] "copy of something in the public domain" will support a copyright if it is a "distinguishable variation". . . . All that is needed to satisfy both the Constitution and the statute is that the "author" contributed something more than a "merely trivial" variation, something recognizably "his own." Originality in this context "means little more than a prohibition of actual copying." No matter how poor artistically the author's addition, it is enough if it be his own.

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34. Both the majority and dissent found that West's case reports have certain characteristics of compilations and derivative works, and that the originality requirement in either case is "essentially the same" and governed by *Feist*. 158 F.3d at 680 and 690, Pet. App. 11a and 39a. In creating its case reports, West acts as a compiler, choosing, for example: (i) the selection and arrangement of the case-report elements; (ii) which citations to include in the opinions; and (iii) what attorney-related data to include, and how to arrange and express it. At the same time, West acts as a derivative work author — updating, revising, annotating, and adding new elements to judicial opinions.

Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102-03 (2d Cir. 1951) (citation and footnotes omitted). The Second Circuit reaffirmed the *Alfred Bell* standard as "the law in this circuit" in *Weissmann v. Freeman*, 868 F.2d 1313, 1321 (2d Cir.), *cert. denied*, 493 U.S. 883 (1989). *See also* Nimmer, *supra*, at § 3.03 (enhancements are protectible if they are "sufficient to render the derivative work distinguishable from its prior work in any meaningful way. . . . ").

The *Alfred Bell* standard — a distinguishable variation that is more than "merely trivial" — plainly imposes no requirement that a derivative work contain "substantial" changes to the "substance and flow" of a preexisting public domain work. However, some courts have adopted a contrary standard that requires changes in a derivative work to be not just non-trivial, but "substantial":

> Two standards have developed within the federal circuits as tests for [derivative work] originality. On one side of the spectrum is the low threshold "distinguishable variation" standard. . . . On the other side of the spectrum is the high threshold "substantial variation" standard used by the Seventh Circuit as expressed in *Gracen v. The Bradford Exchange*, 698 F.2d 300 (7th Cir. 1983).[35]

Gracen has been widely criticized.[36] Some courts have recognized that *Feist*'s "modicum" standard, indisputably applicable to derivative works, effectively overrules any test that requires a "substantial" alteration as a condition for derivative work originality. In *Maljack Productions, Inc. v. UAV Corp.*, 964 F. Supp. 1416, 1426 (C.D. Cal. 1997), *aff'd sub nom. Batjac Productions Inc. v. Goodtimes Home Video Corp.*, 160 F.3d 1223 (9th Cir. 1998), for example, the court held that, in light of *Feist*, "the

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35. Michael F. Bowman, *The Second Circuit's Analysis Of Derivative Works By Joint Authors: Good Law — Poor Application*, 56 Brook. L. Rev. 551, 564-65 (1990).

36. *See, e.g.*, Patry, *supra*, at 162 (the *Gracen* court "misunderstood the [originality] standard altogether").

contention that a derivative work must contain 'substantial originality' in order to receive statutory copyright is simply wrong."

Nonetheless, before and after *Feist*, the "substantial variation" standard has been applied by numerous courts, many of them relying as well on the Second Circuit's use of the word "substantial" in *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976).[37] Yet the facts – and most commentators – suggest that the *Batlin* court was simply applying the minimal *Alfred Bell* standard.[38]

Typically, then, "the Second Circuit has had problems articulating a single standard of originality for derivative works," and the "district courts in the Seventh Circuit . . . are still struggling with the standard of originality for derivative works." Patry, *supra*, at 162 n.170 (1998 Supp.). Thus, the decision in this case further aggravates a pervasive confusion as to whether derivative works

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37. *See, e.g., Woods v. Bourne Co.*, 60 F.3d 978, 990 (2d Cir. 1995) (citing *Gracen* and *Batlin* and using "substantiality" test to deny copyrightability to a piano-vocal arrangement); *Sherry Mfg. Co. v. Towel King of Florida, Inc.*, 753 F.2d 1565, 1568 (11th Cir. 1985) (invoking "substantial" standard, *citing Batlin*). In *Moore Publishing, Inc. v. Big Sky Marketing, Inc.*, 756 F. Supp. 1371, 1375 (D. Idaho 1990), the court expressed the "confusion" in applying *Gracen* and *Batlin*:

> It would appear that a contribution could be more than trivial, but still not substantially different from the preexisting work. Would such a contribution be entitled to protection? The Court need not answer that question.

38. In *Batlin* a plastic replica of an iron toy bank was held not to meet the standard because the replica merely changed the physical medium of the work; it was "practically an exact copy and [any] differences are so infinitesimal they make no difference." 536 F.2d at 489. *See, e.g.*, Nimmer, *supra*, at § 3.03 n.6 ("Batlin did not suggest a new test for derivative work originality. On the contrary, it relied heavily on the teachings of *Alfred Bell*. . . ."); Russ VerSteeg, *Rethinking Originality*, 34 Wm. & Mary L. Rev. 801, 883, n.17 (1993) ("Quite obviously . . . the court in *Batlin* used the term 'substantial variation' merely to delineate a point just above 'trivial,' and not, as Judge Posner suggested in *Gracen*, to forge a new level of variation that was copyrightable").

that contain non-trivial, distinguishable variations are copyrightable. Certainly no prior court has gone so far as to demand that a textual derivative work, adapted from public domain material, is entitled to no copyright protection whatsoever unless it offers "substantial" changes to the "substance and flow" of the underlying work. This fundamental misconstruction of the originality requirement cannot be reconciled with the express statutory provision that derivative works may consist of "editorial revisions, annotations, elaborations, or other modifications . . . ." 17 U.S.C. § 101. Indeed, the Second Circuit's version of the "substantial variation" standard would deny protection to original annotations and cross-references in a newly published edition of Shakespeare's plays; such non-trivial variations do not alter the "substance and flow" of the underlying work in any way, let alone substantially. Similarly, the Second Circuit's standard would deny protection to non-trivial revisions and additions that update an existing work yet leave its "substance and flow" intact.

Clearly, during the past decade, the general principles enunciated in *Feist* have provided insufficient guidance on this issue for the lower courts, whose opinions conflict with each other and with *Feist*. Congress' decision to protect derivative works has now been thrown into even greater doubt by the decision below, which raises serious questions about the copyrightability of works — including annotated versions, revisions, and adaptations — that are critical to every field of learning and every form of expression. Absent review by this Court, the threat of significant underprotection for textual derivative works — precisely the kind of works needed to deal with the dissemination of unannotated and disorganized data of all kinds through new technologies — will discourage the creation of new works in this field. Clarification of this important federal question would benefit all those authors, publishers, and users — from database manufacturers to editors of scholarly editions — who work with facts or who try to give new life and utility to public domain material.

IV.

THE PETITION SHOULD BE GRANTED BECAUSE THE SECOND CIRCUIT DEPARTED FROM LONGSTANDING PRINCIPLES AS TO THE BURDEN OF PROOF IN DECLARATORY JUDGMENT ACTIONS

The order below permits verbatim copying of tens of thousands of unspecified, individual *Supreme Court Reporter* and *Federal Reporter* case reports. The finding that none of these reports could contain protectible expression is based on impermissible speculation and an improper allocation of the burden of proof. HyperLaw never attempted to offer — and the decisions below do not refer to — any purported analysis of West's work based on a review of a representative, statistically significant sampling of the reports. For example, HyperLaw limited its evidence regarding *Federal Reporter* to a partial one-volume sampling reflecting West's adaptation of opinions from only three of the thirteen circuits despite the undisputed fact that West's work varies from circuit to circuit. Moreover, HyperLaw never specified which, or how many, case-reports it intended to copy.

The record below could not even theoretically support a finding that strips West of protection for all *Supreme Court Reporter* and *Federal Reporter* reports. This Court's guidance is needed because the Second Circuit's affirmance of this speculative and sweeping declaratory judgment throws into question the well-settled principle that the party seeking relief bears the burden of proof in declaratory actions. *See, e.g.*, 10B C.A. Wright, A.R. Miller & M.K. Kane, FEDERAL PRACTICE AND PROCEDURE: CIVIL § 2770 (3d ed. 1998).

V.

THE PETITION SHOULD BE GRANTED SO THAT THIS COURT CAN ADDRESS JUDICIAL DIVISION AS TO THE PROPER STANDARD OF REVIEW IN CASES INVOLVING COPYRIGHT ORIGINALITY

The Second Circuit's ruling that findings as to copyright originality always are reviewed for clear error (158 F.3d at 681,

Pet. App. 12a-13a) conflicts with principles enunicated by this Court and with the rule in other circuits. This Court has enunicated the general principle that the proper standard of review for an application of law to fact is *de novo* unless the inquiry is founded on the lower court's "experience with the mainsprings of human conduct" (*e.g.*, questions of intent or reasonableness). *C.I.R. v. Duberstein*, 363 U.S. 278, 289, 80 S. Ct. 1190, 1198 (1960). Application of the Copyright Act's originality standard to undisputed facts is, by contrast, an inquiry focused on judgment about the values that animate legal principles. *Cf. United States v. General Motors Corp.*, 384 U.S. 127, 141, n.16, 86 S. Ct. 1321, 1328, n.16 (1966) ("the question here is not one of 'fact,' but rather of the legal standard required to be applied to the undisputed facts").

As the First Circuit recently noted, *Feist* — deciding originality as a matter of law — makes it clear that originality is essentially a legal inquiry when the facts are undisputed. *CMM Cable Rep, Inc. v. Ocean Coast Properties, Inc.*, 97 F.3d 1504, 1417 (1st Cir. 1996). *See also Los Angeles News Serv. v. Tullo*, 973 F.2d 791, 793 (9th Cir. 1992) ("Whether the raw tapes are sufficiently original to merit copyright protection is a mixed question of law and fact that we examine de novo."). Yet the Second Circuit and other circuits apply a contrary rule, and only this Court can resolve this fundamental inconsistency and confusion in the administration of the Copyright Act.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this petition should be granted.

Respectfully submitted,

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APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT DATED NOVEMBER 3, 1998 AND FILED NOVEMBER 4, 1998

UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

August Term, 1997

(Argued: March 16, 1998 Decided: November 3, 1998)

Docket No. 97-7910

MATTHEW BENDER & COMPANY, INC.,

Plaintiff,

HYPERLAW, INC.,

Intervenor-Plaintiff-Appellee,

– v.–

WEST PUBLISHING CO. and WEST PUBLISHING CORPORATION,

Defendants-Appellants.

Before: CARDAMONE and JACOBS, *Circuit Judges*, and SWEET,* *District Judge.*

* * *

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* The Honorable Robert W. Sweet, of the United States District Court for the Southern District of New York, sitting by designation.

Appendix A

JACOBS, *Circuit Judge*:

West Publishing Co. and West Publishing Corp. (collectively "West") publish compilations of reports of judicial opinions ("case reports"). Each case report consists of the text of the judicial opinion with enhancements that for the purposes of this case can be put in two categories: (i) independently composed features, such as a syllabus (which digests and heralds the opinion's general holdings), headnotes (which summarize the specific points of law recited in each opinion), and key numbers (which categorize points of law into different legal topics and subtopics), and (ii) additions of certain factual information to the text of the opinions, including parallel or alternative citations to cases, attorney information, and data on subsequent procedural history. HyperLaw, Inc. publishes compact disc-read only memory ("CD-ROM") compilations of Supreme Court and United States Court of Appeals decisions, and intervened as a plaintiff to seek a judgment declaring that the individual West case reports that are left after redaction of the first category of alterations (*i.e.*, the independently composed features), do not contain copyrightable material. West now appeals from a judgment of the United States District Court for the Southern District of New York (Martin, *J.*), following a bench trial, granting declaratory judgment in favor of HyperLaw. *Matthew Bender & Co. v. West Publ'g Co.*, No. 94 Civ. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997).

It is true that neither novelty nor invention is a requisite for copyright protection, but minimal creativity is required. Aside from its syllabi, headnotes and key numbers — none of which HyperLaw proposes to copy — West makes four

different types of changes to judicial opinions that it claimed at trial are copyrightable: (i) rearrangement of information specifying the parties, court, and date of decision; (ii) addition of certain information concerning counsel; (iii) annotation to reflect subsequent procedural developments such as amendments and denials of rehearing; and (iv) editing of parallel and alternate citations to cases cited in the opinions in order to redact ephemeral and obscure citations and to add standard permanent citations (including West reporters). All of West's alterations to judicial opinions involve the addition and arrangement of facts, or the rearrangement of data already included in the opinions, and therefore any creativity in these elements of West's case reports lies in West's selection and arrangement of this information. In light of accepted legal conventions and other external constraining factors, West's choices on selection and arrangement can reasonably be viewed as obvious, typical, and lacking even minimal creativity. Therefore, we cannot conclude that the district court clearly erred in finding that those elements that HyperLaw seeks to copy from West's case reports are not copyrightable, and affirm.

BACKGROUND

West obtains the text of judicial opinions directly from courts. It alters these texts as described above to create a case report, and then publishes these case reports (first in advance sheets, then in bound volumes) in different series of "case reporters."[1] These case reporter series cover all state and

1. West also functions as the publisher of slip opinions — *i.e.*, the official versions of court opinions — for the Fifth and Eleventh Circuits, and West does not claim a copyright for any alterations it makes to those slip opinions other than its syllabi, headnotes, and key numbers.

federal courts and are collectively known as West's "National Reporter System." Two series of case reporters are at issue in this case: the *Supreme Court Reporter*, which contains, *inter alia*, all Supreme Court opinions and memorandum decisions; and the *Federal Reporter*, which contains, *inter alia*, all United States Court of Appeals opinions designated for publication, as well as tables showing the disposition of unpublished cases.

HyperLaw markets two compilations that cover approximately the same ground: *Supreme Court on Disc*, an annual CD-ROM disc containing opinions of the United States Supreme Court starting from 1990; and *Federal Appeals on Disc*, a quarterly CD-ROM disc containing nearly all opinions (published and unpublished) of the United States Courts of Appeals from January 1993 on.[2] Currently, HyperLaw obtains the text of the opinions directly from the courts. However, HyperLaw intends to expand its CD-ROM product to include any recent cases it could not obtain directly from the courts (and attorney information that is omitted from slip opinions by certain circuits), as well as pre-1990 Supreme Court cases and pre-1993 court of appeals cases that are cited in recent Supreme Court and court of appeals cases (so that users can jump to those cases). HyperLaw intends to achieve this expansion by copying West's case reports (after redacting the syllabi, headnotes and key numbers) from the *Supreme Court Reporter* and the *Federal Reporter*. The total number of opinions HyperLaw intends to copy is unclear; but HyperLaw's President Alan Sugarman testified that in time

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2. The record seems to indicate that since the commencement of this suit, HyperLaw has combined these two products into one.

it could reach 50 percent of Supreme Court and court of appeals decisions published by West.

Following the commencement of suit by Matthew Bender & Co. in the United States District Court for the Southern District of New York seeking a judgment declaring that Bender's insertion of star pagination to West's case reporters in its CD-ROM version of judicial opinions did not infringe West's copyright, HyperLaw intervened and requested the same relief. In addition, HyperLaw sought a declaration that HyperLaw's redacted versions of West's case reports contain no copyrightable material and thus may be copied without infringement. On the star pagination issue, the district court granted summary judgment to Bender and HyperLaw, and final judgment was entered pursuant to Fed. R. Civ. P. 54(b). (We affirm that ruling in a separate opinion issued today. *See Matthew Bender & Co. v. West Publ'g Co.*, No. 97-7430.) But the district court denied summary judgment allowing HyperLaw to copy redacted versions of West's case reports, and conducted a bench trial on this issue.

The principal trial witness was Donna Bergsgaard, the manager of West's manuscript department. She specified four kinds of alterations made by West to the opinions that it publishes in the *Supreme Court Reporter* and *Federal Reporter* and that HyperLaw intends to copy: (i) the arrangement of prefatory information, such as parties, court, and date of decision; (ii) the selection and arrangement of the attorney information; (iii) the arrangement of information relating to subsequent procedural developments; and (iv) the selection of parallel and alternative citations.

Appendix A

Following the bench trial, the district court ruled that West's revisions to judicial opinions were merely trivial variations from the public domain works, and that West's case reports were therefore not copyrightable as derivative works. *Matthew Bender & Co.*, 1997 WL 266972, at *4. In reaching this conclusion, the district court reviewed each type of alteration and found that "West does not have a protectible interest in any of the portions of the opinions that HyperLaw copies or intends to copy" because West's alterations lack even minimal creativity. *Id.*

DISCUSSION

I

As a threshold matter, West argues that the judgment should be vacated and the action dismissed as moot because HyperLaw failed to demonstrate through admissible evidence a sufficiently real intent to copy West's case reports in quantities beyond what West conceded (immediately prior to trial) would be permissible under the fair use doctrine, *i.e.*, one to two percent of its published reports of Supreme Court and court of appeals cases.

Early in the litigation, the district court held a justiciability hearing and concluded that HyperLaw had the ability and intent to copy certain elements of West's case reports and that if HyperLaw did so, it faced a reasonable apprehension of suit. But a dispute remained as to the scope of HyperLaw's intended copying. Prior to trial, West argued that HyperLaw intended no copying of West's case reports other than the few recent court decisions that HyperLaw had

not obtained from the courts, and West preemptively conceded that such copying was permitted under the fair use doctrine. HyperLaw contested West's characterization of the scope of its intended copying, and pointed to an affidavit (submitted earlier in the litigation) in which Alan Sugarman, HyperLaw's president, expressed HyperLaw's intent to copy opinions from earlier years cited in opinions included on their CD-ROM discs.

Faced with West's last-minute concession, the district court reserved decision on West's motion to dismiss for mootness and proceeded with the bench trial, at which HyperLaw would have the opportunity to offer testimony on the percentage of West case reports it intended to copy. After the close of evidence, West moved to dismiss for mootness on the ground that HyperLaw neglected to adduce such evidence. The district court, however, permitted HyperLaw to remedy its omission by offering Sugarman's affidavit on that subject for the truth of the matters stated therein, subject to West's opportunity to cross-examine Sugarman. During this cross-examination, Sugarman testified that HyperLaw intended to copy most older cases cited in recent Supreme Court and court of appeals decisions included on the CD-ROM discs; he estimated that this copying might approximate half of West's case reports. On the basis of Sugarman's testimony, the district court concluded that a live controversy existed. We cannot find that this determination was in error.

West's mootness argument amounts to a claim that the district court erred in admitting Sugarman's testimony following the close of evidence. A district court's decision to reopen the proof to allow a party to submit additional

evidence is subject to its sound discretion. *See Zenith Radio Corp. v. Hazeltine Research, Inc.*, 401 U.S. 321, 331, 91 S. Ct. 795, 802-03 (1971); *see also* Fed. R. Civ. P. 59(a) ("On a motion for a new trial in an action tried without a jury, the court may open the judgment if one has been entered, take additional testimony, amend findings of fact and conclusions of law or make new findings and conclusions, and direct the entry of a new judgment."). The district court's decision to receive Sugarman's testimony in evidence is therefore reviewed for abuse of discretion. *See Air et Chaleur, S.A. v. Janeway*, 757 F.2d 489, 495 (2d Cir. 1985); *see also Garcia v. Woman's Hosp.*, 97 F.3d 810, 814 (5th Cir. 1996) ("Among the factors the trial court should examine in deciding whether to allow a reopening are the importance and probative value of the evidence, the reason for the moving party's failure to introduce the evidence earlier, and the possibility of prejudice to the non-moving party.").

Sugarman's testimony should have been offered earlier; but (i) the testimony was important for determining the existence of a live controversy, (ii) West was afforded a full opportunity for cross-examination, and (iii) West points to no specific prejudice from the delay. Furthermore, the district court's decision served judicial efficiency; otherwise, the case would have been dismissed as moot without preclusive effect, HyperLaw would have simply amended its complaint to allege its intent to engage in more extensive copying, and the case would have been re-tried. The district court's admission of Sugarman's testimony did not amount to an abuse of discretion.

Appendix A

II

Works of the federal government are not subject to copyright protection; the text of judicial decisions may therefore be copied at will. 17 U.S.C. § 105. Federal judicial opinions may, however, form part of a compilation. The Copyright Act defines "compilation" as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101. West has filed a certificate of copyright registration for every paperbacked advance sheet and bound permanent volume of the *Supreme Court Reporter* and *Federal Reporter*, and each certificate characterizes the copyrighted work as a "compilation." Under *Feist Publications, Inc. v. Rural Telephone Serv. Co.*, 499 U.S. 340, 111 S. Ct. 1282 (1991), an infringement claim for a compilation has two elements: "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." *Id.* at 361; 111 S. Ct. at 1296.

But HyperLaw has not signaled its intent to copy the text of every case included in particular volumes of West case reporters or the case reporters' selection and arrangement of cases;[3] HyperLaw's intent is to copy particular, though numerous, individual case reports. HyperLaw seeks a declaratory judgment that these case reports — after removal

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3. Whether insertion of star pagination to West's case reporters amounts to copying of West's arrangement of cases is a separate question we address in the other opinion issued today. *See Matthew Bender & Co. v. West Publ'g Co.*, No. 97-7430.

of the syllabus, headnotes, and key numbers — contain no copyrightable material.

A

HyperLaw contends that each case report should be analyzed as a *derivative* work, which is defined under the Copyright Act as, *inter alia*, "[a] work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship." 17 U.S.C. § 101. The district court adopted this view and analyzed the individual case report as a derivative work, but found it wanting in the requisite originality. West contends that each case report is a *compilation*, *i.e.*, a collection of facts that have been distinctively selected and arranged. No one claims that a case report is anything other than a derivative work or a compilation.

The House Report on the 1976 Copyright Act distinguishes between a derivative work and a compilation:

> Between them the terms . . . comprehend every copyrightable work that employs preexisting material or data of any kind. There is necessarily some overlapping between the two, but they basically represent different concepts. A "compilation" results from a process of selecting, bringing together, organizing, and arranging previously existing material of all kinds, regardless of whether the individual items in the material have been or ever could have been subject to copyright. A "derivative work," on the other hand,

> requires a process of recasting, transforming, or adapting "one or more preexisting works"; the "preexisting work" must come within the general subject matter of copyright set forth in section 102, regardless of whether it is or was ever copyrighted.

H.R. Rep. No. 94-1476, at 57 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5670; *see also* 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 3.02, at 3-5 (1998) ("[W]hile a compilation consists merely of the selection and arrangement of pre-existing material without any internal changes in such material, a derivative work involves recasting or transformation, *i.e.*, changes in the pre-existing material, whether or not it is juxtaposed in an arrangement with other pre-existing materials.").

We think that West's case reports have elements of both types of works. West compiles (and selects) the factual information it includes in each case report — the type of task usually involved in creating a compilation. On the other hand, West rearranges prefatory and citation information included in judicial opinions, steps that tend toward the making of a derivative work rather than a compilation. In addition, all of West's decisions are constrained by West's main project, which is to enhance the judicial opinions without altering their texts in any substantive or appreciable way.

We need not categorize West's case reports as either derivative works or compilations in order to decide this case. Copyright protection is unavailable for both derivative works and compilations alike unless, when analyzed as a whole, they display sufficient originality so as to amount to an

"original work of authorship." *See* 17 U.S.C. § 101 (defining a "derivative work", *inter alia*, as a work containing alterations "which, as a whole, represent an original work of authorship"); *id.* (defining a compilation as requiring that "the resulting work as a whole constitutes an original work of authorship"). The originality required for copyright protection is essentially the same. *See Feist*, 499 U.S. at 358, 111 S. Ct. at 1294 ("Originality requires only that the author make the selection or arrangement independently . . . and that it display some minimal level of creativity."); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490-91 (2d Cir. 1976) (*in banc*) ("[W]hile a copy of something in the public domain will not, if it be merely a copy, support a copyright, a distinguishable variation will. * * * [T]o support a copyright there must be at least some substantial variation, not merely a trivial variation such as might occur in the translation to a different medium."). As West and HyperLaw seemingly agree, the question presented is whether West's alterations to the case reports, when considered collectively, demonstrate sufficient originality and creativity to be copyrightable.

B

The district court found that the elements of the West case reports for which West seeks copyright protection lack sufficient originality or creativity to be protectable — whether considered separately or together. Because we treat the question of whether particular elements of a work demonstrate sufficient originality and creativity to warrant copyright protection as a question for the factfinder — here the judge — we will not reverse the district court's findings unless clearly erroneous. *See, e.g., Victor Lalli Enters., Inc. v. Big*

Red Apple, Inc., 936 F.2d 671, 673 (2d Cir. 1991) (*per curiam*) ("Generally, we review a district court's determination of whether a work is sufficiently original to merit copyright protection under the clearly erroneous standard."); *Financial Info., Inc. v. Moody's Investors Serv., Inc.*, 808 F.2d 204, 207-08 (2d Cir. 1986) (same); *see also Woods v. Bourne Co.*, 60 F.3d 978, 991 (2d Cir. 1995) (noting that our review of originality determination is for clear error); *Weissmann v. Freeman*, 868 F.2d 1313, 1322 (2d Cir. 1989) (holding that the district court's finding of lack of originality or variation in derivative work was reviewable for clear error). The dissent (at 38a, footnote 1) argues that *de novo* review would be more appropriate, and that our precedents to the contrary are doubtful in light of *Feist*. *Feist*, however, did not address standard of review, and the clear error standard retains vitality in our precedents, both before and after *Feist*. In 1995, we acknowledged that the question of copyrightability entails the kind of conclusion that would often justify *de novo* review, but that most courts, including this Court, review for clear error. *See Woods*, 60 F.3d at 991 (Feinberg, *J.*) (citing 1 William F. Patry, *Copyright Law and Practice* 145 n.106 (1994) (cataloguing cases)).

The only elements of a work that are entitled to copyright protection are those that are original. *See Feist*, 499 U.S. at 361, 111 S. Ct. at 1296; *Mid America Title Co. v. Kirk*, 59 F.3d 719, 721 (7th Cir. 1995). The "originality" standard requires that the work result from "independent creation" *and* that the author demonstrate that such creation entails a "modicum of creativity." *See Feist*, 499 U.S. at 346, 111 S. Ct. at 1288; *see also Key Publications, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 512-13 (2d Cir.

1991) ("Simply stated, original means not copied, and exhibiting a minimal amount of creativity.").

According to West, the required originality and creativity inhere in four elements of the case reports that HyperLaw intends to copy:

> (i) the arrangement of information specifying the parties, court, and date of decision;
>
> (ii) the selection and arrangement of the attorney information;
>
> (iii) the arrangement of information relating to subsequent procedural developments such as amendments and denials of rehearing; and
>
> (iv) the selection of parallel and alternative citations.[4]

Each element either adds or rearranges preexisting facts, in themselves unprotectable, and so West is not entitled to protection for these elements of its case reports unless it demonstrates creativity in the selection or arrangement of those facts. *See Feist*, 499 U.S. at 348, 111 S. Ct. at 1289. Because many of the cases relating to compilations assess

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4. West initially claimed some creativity in its corrections to the text of opinions, but it has abandoned this claim, presumably because these corrections either are trivial (*i.e.*, punctuation or spelling), or else (nearly always) approved by the courts by order or informal means.

the creativity involved in selecting and arranging information, we look to those cases for guidance.

The Copyright Act protects original and minimally creative selection of preexisting, unprotected materials (such as facts) for inclusion in a work, as well as original and creative arrangement of those materials. *See Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984) ("[S]electivity in including otherwise non-protected information can be protected expression."); 1 Nimmer, *supra*, § 3.04[B][2], at 3-31 ("If originally combined, a selection or arrangement of underlying materials that are themselves unoriginal may support copyright protection."). *Feist* tells us:

> The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws.

Feist, 499 U.S. at 348, 111 S. Ct. at 1289 (citations omitted).[5] However, not every such compilation or decision on selection or arrangement is sufficiently creative to be protected.

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5. We have previously explained that the protection of compilations "is consistent with the objectives of the copyright law

(Cont'd)

The creative spark is missing where: (i) industry conventions or other external factors so dictate selection that any person composing a compilation of the type at issue would necessarily select the same categories of information, *see, e.g., Victor Lalli Enters.*, 936 F.2d at 672 (charts of winning numbers in illegal gambling operations); *see also Mid America Title Co.*, 59 F.3d at 722 (title examiner's report; "[s]electing which facts to include in this compilation of data was not a matter of discretion based on Mid America's personal judgment or taste, but instead it was a matter of convention and strict industry standards"), or (ii) the author made obvious, garden-variety, or routine selections, *see Feist*, 499 U.S. at 362, 111 S. Ct. at 1296 (concluding that the selection and arrangement of a white pages in which the publisher had chosen to include name, town and telephone number, and to arrange these listings in alphabetical order were entirely "typical" and "garden-variety"); *BellSouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g, Inc.*, 999 F.2d 1436, 1444 (11th Cir. 1993) (*in banc*) (holding that the categories for the organization of material in a yellow pages directory lacked creativity where many of the selected

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(Cont'd)

. . . to promote the advancement of knowledge and learning by giving authors economic incentives . . . to labor on creative, knowledge-enriching works" because compilations "that devise new and useful selections and arrangements of information . . . contribute to public knowledge by providing cheaper, easier, and better organized access to information." *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 65-66 (2d Cir. 1994). Without that financial incentive, such compilations would not be created. *Id.* at 66. Nevertheless, it is not a goal of copyright law to promote the production of compilations which lack sufficient creativity.

headings, such as "Attorneys" or "Banks" are so obvious and many others "result from certain standard industry practices").

Thus, when it comes to the selection or arrangement of information, creativity inheres in making non-obvious choices from among more than a few options. *See, e.g., Hearn v. Meyer*, 664 F. Supp. 832, 847 (S.D.N.Y. 1987) ("Copyright protection is afforded rarely where a fact permits only a narrow continuum or spectrum of expression."). For example, in *Kregos v. Associated Press*, 937 F.2d 700, 704 (2d Cir. 1991), the decision to express a pitcher's performance in terms of nine statistics from "at least scores of available statistics about pitching performance available to be calculated from the underlying data and therefore thousands of combinations of data that a selector can choose to include in a pitching form" was not necessarily obvious or self-evident. We therefore concluded that the district court erred in granting summary judgment on the uncopyrightability of the pitching forms. *Id.* at 704-05, 711; *see also American Dental Ass'n v. Delta Dental Plans Ass'n*, 126 F.3d 977, 979 (7th Cir. 1997) (holding taxonomy of dental procedures creative after noting that they "could be classified . . . in any of a dozen different ways"). However, selection from among two or three options, or of options that have been selected countless times before and have become typical, is insufficient. Protection of such choices would enable a copyright holder to monopolize widely-used expression and upset the balance of copyright law.

In sum, creativity in selection and arrangement therefore is a function of (i) the total number of options available, (ii) external factors that limit the viability of certain options

and render others non-creative, and (iii) prior uses that render certain selections "garden variety." *See, e.g.*, 1 Patry, *supra*, at 196 ("As a general principle, the greater the amount of material from which to select, coordinate, or arrange, the more likely it is that a compilation will be protectible. On the other hand, where less material is available, it is less likely that a compilation, even if original, will be protectible, since *de minimis* efforts, including selections, are not subject to copyright.").

C

We proceed to assess the originality and creativity underlying the elements of West's case reports that HyperLaw seeks to copy.

1. Captions, Courts, and Date Information

West claims that originality inheres in the following enhancements:

> • The format of the party names — the "caption" — is standardized by capitalizing the first named plaintiff and defendant to derive a "West digest title," and sometimes the party names are shortened (*e.g.*, when one of the parties is a union, with its local and national affiliations, West might give only the local chapter number, and then insert *etc.*).[6]

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6. West offered as evidence at trial memoranda to its editors concerning caption alterations. Review of these memoranda (Cont'd)

- The name of the deciding court is restyled. *E.g.*, West changes the slip opinion title of "United States Court of Appeals for the Second Circuit" to "United States Court of Appeals, Second Circuit."

- The dates the case was argued and decided are restyled. *E.g.*, when the slip opinion gives the date on which the opinion was "filed," West changes the word "filed" to "decided."

- The caption, court, docket number, and date are presented in a particular order, and other information provided at the beginning of some slip opinions is deleted (such as the lower court information, which appears in the West case syllabus).

We do not think that the district court committed clear error in finding that these changes are insubstantial, unoriginal, and uncreative. Reference to a case by the names of the first plaintiff and first defendant is a garden variety

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(Cont'd)
demonstrates that they are simply concerned with accurate presentation of caption information. For example, they clarify the accurate family name for parties of Chinese or Spanish origin so that the editor capitalizes the proper name in the caption. They also set forth a uniform system for abbreviating certain words, which is not original or copyrightable. *See, e.g.*, *Brief English Sys., Inc. v. Owen*, 48 F.2d 555, 556 (2d Cir. 1931) ("There is no literary merit in a mere system of condensing written words into less than the number of letters usually used to spell them out.").

decision. *See, e.g., The Bluebook: A Uniform System of Citation* rule 10.2.1(a) (16th ed. 1996) (hereinafter "*The Bluebook*"). The same is true of West's manner of shortening long case names. *See, e.g., id.* rule 10.2.1(i) ("Cite a union name exactly as given in the official reporter, except that: (i) only the smallest unit should be cited . . . (ii) all craft or industry designations . . . should be omitted. . . ."). Even if these choices regarding which words to capitalize and shorten to form the West digest title were an original inspiration, we doubt the decisions to shorten the titles or capitalize certain letters would be copyrightable. *See Secure Servs. Tech., Inc. v. Time & Space Processing, Inc.*, 722 F. Supp. 1354, 1363 n.25 (E.D. Va. 1989) ("Size of print . . . is not copyrightable."); 37 C.F.R. § 202.1(a) (1998) ("Words and short phrases such as names [and] titles . . . mere variations of typographic ornamentation [or] lettering" are not copyrightable.). Nor does West's overall choice concerning which procedural facts to include at the start of the case report demonstrate the requisite originality or creativity: The names of the parties, the deciding court, and the dates of argument and decision are elementary items, and their inclusion is a function of their importance, not West's judgment. *Cf. Kregos*, 937 F.2d at 702 (noting that "there can be no claim of a protectable interest in the categories of information concerning each day's [baseball] game," including the teams, starting pitchers, the game time, and the betting odds).

2. Attorney Information

The second claimed creative element is West's selection and arrangement of attorney information. The Supreme Court slip opinions and some slip opinions of the courts of appeals

omit some or all of the information about counsel that West compiles from the docket sheets and from other sources. For Supreme Court opinions, West lists the arguing counsel and the lawyer's city and state of practice; for court of appeals decisions, West lists the names of briefing attorneys as well as arguing attorneys, and specifies each lawyer's city and state of practice and law-firm or agency affiliation.

Here again we agree with the district court that West's decisions lack a modicum of creativity. Like the name, town and telephone number included in Feist's telephone directory, the information West includes — attorney names, firms and cities of practice — is entirely "typical" and "garden-variety." *See, e.g., Skinder-Strauss Assocs. v. Massachusetts Continuing Legal Educ., Inc.*, 914 F. Supp. 665, 676 (D. Mass. 1995) (noting that "[i]n compiling a Massachusetts directory of lawyers and judges, . . . [t]he 'selection' of other directory data, including the attorney name, address, telephone and fax numbers, year of bar admission, and so forth are . . . unoriginal and determined by forces external to the compiler"); *cf. Key Publications, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991) (emphasizing the creativity inherent in designating phone-book classifications of particular interest to Chinese-Americans). In fact, most courts (this one included) provide the very same information in their slip opinions.

West's decision to provide more information about counsel in the court of appeals case reports, and less in the Supreme Court case reports does not strike a creative spark because the options available to a publisher are simply too limited. West's claim illustrates the danger of setting too low

a threshold for creativity or protecting selection when there are two or three realistic options: West lists only the arguing attorneys and city of practice, while *United States Law Week* lists the arguing and briefing attorneys, their firm affiliations and city and state of practice. If both of these arrangements were protected, publishers of judicial opinions would effectively be prevented from providing any useful arrangement of attorney information for Supreme Court decisions that is not substantially similar to a copyrighted arrangement.

3. Subsequent History

West's case reports reflect certain subsequent procedural developments, such as orders amending an opinion or denying rehearing. The district court found that West's alteration of opinions to reflect these subsequent case developments does not reflect an exercise of originality or creativity, in part because West's realistic options are limited. We cannot say that this was clear error.

In most appeals, the only subsequent development is a denial of rehearing. West's manuscript manager Bergsgaard described two possible ways to reflect this action: (i) a file line, inserted at the beginning of the case just after the date of the original decision, which simply states "rehearing denied" and the date of the denial, or (ii) a table containing the same information. West has chosen to reflect denial of rehearing via a file line. Neither this choice, nor the actual language used to reflect the denials ("rehearing denied" followed by the date), is creative or requires judgment.

Appendix A

As the trial testimony reflects, subsequent orders sometimes reflect more extensive changes or additions to opinions, such as amendments to the original opinion (ranging from minimal to extensive), or subsequent opinions upon denial of rehearing or in dissent from denial of rehearing or rehearing *in banc*. The actual text of any amendments to opinions or new opinions issued with the denial of rehearing will always be the court's. But West points to the following available options for reflecting these changes, and claims that its choice from among these options is creative: (i) printing the order in full at the end of the opinion; (ii) altering the text of the opinion to reflect the amendments; (iii) publishing the order separately from the original opinion in a different volume and cross-referencing to the original opinion; or (iv) reprinting the original opinion in full with the changes reflected in the text.

Almost never will these decisions present more than one or two realistic or useful options, and almost always the choice among them will be dictated by the timing of the court action. For example, an order amending an opinion will either (i) reflect the exact locations in the opinion where changes are to be made, in which case the obvious preference is to alter the text of the opinion, or (ii) include some general language modifying the opinion, in which case the obvious preference is to print the order at the end of the text of the opinion. If the opinion has not yet gone to print in an advance sheet or a bound volume, West will actually make these changes in the original opinion. If the opinion has already been printed in the bound volume, then West (once again) has only binary options: (i) print only the order and cross-reference to the original opinion, or (ii) reprint the opinion

in full, incorporating the changes and/or publishing the order at the end of the opinion. As set forth in the margin, West's exemplar confirms how little judgment is exercised even in a case with a complicated subsequent procedural history.[7] West also adds a file line explaining the action, but the line merely sets forth the court's action. Given the few practical options available to West, and the fact that the choice among these narrow options will be dictated by the timing and nature of the court's action, we do not think the district court clearly erred in determining that this element of West's case reports does not demonstrate sufficient creativity to be protectable.

4. Parallel or Alternate Citations

As the district court recognized, the element of West's case reports that raises the closest question as to creativity is West's emending of the citations, as follows:

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7. West focuses on its case report for *Roulette v. City of Seattle*, decided in March 1996 and published at 78 F.3d 1425 (9th Cir. 1996). In September 1996, there issued an order amending the opinion upon denial of rehearing and suggestion for rehearing *in banc*, and two opinions dissenting from the denial of rehearing *in banc*. The order amending the opinion made substantial substantive changes to the opinion, and so West decided to republish the full opinion with the changes reflected in the text at 97 F.3d 300 (9th Cir. 1996). Moreover, it printed the full order (with a note indicating that the amendments to the opinion were included in the text) with the dissenting opinions at the end of the opinion. Finally, it added a file line reflecting those developments. None of these decisions demonstrates the exercise of any creativity; in fact, with the exception of the file line, all were dictated by the changes made to the opinion by the court. The Ninth Circuit did the same thing, *i.e.*, republished the original opinion incorporating the amendments and printed the order and dissents in full following the text.

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(a) West inserts parallel citations when the judicial opinion does not, *e.g.*, (i) for citations to Supreme Court opinions, it inserts parallel citations to *United States Reports*, *Supreme Court Reporter*, and *Lawyer's Edition*, (ii) for citations to a state court, West inserts parallel citations to the official reporter and West's regional reporter, and (iii) for citations to looseleaf, specialized, or electronic reporters, West inserts parallel citations to a West National Reporter System ("NRS") reporter or Westlaw (West's on-line database);

(b) West substitutes some court citations, *e.g.*, if the court cites to a slip opinion that has been published in an NRS reporter, West will substitute a citation to the NRS reporter; and

(c) West adds citations when the opinion refers to a case by name but does not insert a citation.

The district court concluded that "[i]n most instances the determination of which parallel citations to include . . . reflect[s] no level of originality," and that the "selections made tend to conform to the standard of the legal profession and appear consistent with those recommended in *A Uniform System of Citation*." *Matthew Bender & Co.*, 1997 WL 266972, at *4.

We cannot find that the district court's conclusion was unreasonable. West claims that it exercises careful judgment as to which sources are most useful to legal practitioners.

However, almost every one of West's decisions relating to citation alterations is inevitable, typical, dictated by legal convention, or at best binary. *See* 1 Patry, *supra*, at 196-97 ("Even where theoretically there is a large number of items to choose from, functional, commercial, or legal constraints may limit, or even bar, protectibility."). And each case report exhibits only one or two decisions on how to alter citations.

West has issued a series of memoranda to its editors that contain guidelines for citation alterations (a complete list of the citational instructions is set out in the margin[8]). Most of

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8. West has issued the following guidelines for citation alterations:

> (1) follow certain prescribed formats for abbreviation of Rules of Civil Procedure, state rules, and statutes.
>
> (2) add a citation to Westlaw or to an NRS case reporter for citations to certain looseleaf services when the case cannot be directly retrieved through Westlaw using the looseleaf service citation.
>
> (3) substitute an NRS case reporter cite for 15 publications, almost all of which are daily or weekly reports or journals, including: *Arizona Advance Reports*, *California Daily Appellate Report*, *9th Circuit Daily Journal*, *Florida Law Weekly*, *Oklahoma Bar Journal*, *Texas Supreme Court Journal*, and *United States Law Week*.
>
> (4) add an NRS case reporter or Westlaw cite for 15 publications, some of which are topical publications and

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others of which are competitor publications, including: *American Law Reports* (A.L.R.), *Board of Tax Appeals*, *Federal Sentencing Reporter*, *Idaho Bankruptcy Court Reports*, *Pennsylvania Fiduciary*, and *Virgin Islands Reports*.

(5) for citations to cases appearing in tables in West case reporters, include a Westlaw cite if Westlaw contains the full-text of the summary order.

(6) if the court's citation indicates that a petition for certiorari has been filed and the Supreme Court has acted on the petition:

(a) if the petition has been denied and the date of the denial was prior to the date the opinion was decided, add the citation for the denial of certiorari.

(b) if the petition was denied after the opinion was decided, do not add a citation for the denial of certiorari.

(c) if the petition was granted, check with the court to see if the case citation should be retained.

(7) if a court includes a short form citation for a case which has not yet been cited in full in the opinion, insert the full citation.

(8) if a court cites to a slip opinion, add the NRS case reporter citation. If this citation is unavailable prior to publication, add a Westlaw citation.

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Appendix A

West's citation guidelines need no discussion because they involve obvious, garden-variety decisions to cite to West NRS case reporters and to Westlaw whenever the court has cited

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(9) add extension pages for citations if the court's NRS citation includes an extension page.

(10) change internal page references in the slip opinion to dashes so that a reporter page number can be inserted by West editors.

(11) add a Westlaw or NRS case reporter citation for public utility citations.

(12) do not remove citations in opinions to public domain citation systems in those jurisdictions that have adopted such citation systems, including the Sixth Circuit and South Dakota.

(13) add a Westlaw citation when the court includes a LEXIS citation, and in certain situations, remove the LEXIS citation.

(14) add a citation for a case referenced in the text of the opinion without citation unless that case appears on a list of 300 popular case names.

(15) add parallel citations for Supreme Court decisions to *United States Reports*, *Supreme Court Reporter*, and *Lawyer's Edition*.

(16) add parallel citations for state court decisions to an NRS regional case reporter and the state's official reporter.

to sources that are not easily accessible, such as looseleaf or daily or weekly reporter services or slip opinions; there are few options to begin with, and West's case reporters and Westlaw have the widest availability and have essentially become the standard citation to case law. *See, e.g., The Bluebook, supra*, at 165-225 (recommending citation to West federal and regional reporters for all federal and state courts, with the exception of the Supreme Court, for which *Supreme Court Reporter* is listed as a secondary cite); *id.* rule 10.3.1 (recommending citation to West regional reporters, and if not published therein, to a "widely used computer database" or to a "service," in that order of preference). No evaluative judgment is involved in a decision to cite to those two sources (especially given West's self-interest in including citations to its own products).

As for the other guidelines, the following represent the citation decisions that receive the most emphasis by West, and that represent most, if not all, of the examples of citation alterations included in cases that West offered into evidence at trial:

> • West's decision to insert a citation to the denial of certiorari only when the denial pre-dated the opinion is necessary to avoid anachronism, and is in any event a choice among two or three options at most.[9] *See, e.g., BellSouth Adver. & Publ'g*

9. Even West notes in its brief, "Every publisher has at least three options [on how to update citations in slip opinions] — to leave citations as they appear in the opinion, to update them as of the date of case-report publication, or to update them only as of the date of the original order."

Corp. v. Donnelley Info. Publ'g, Inc., 999 F.2d 1436, 1441 (11th Cir. 1993) (*in banc*) (holding that determination of closing date after which no changes were included in the yellow pages at issue did not demonstrate creativity in selection because "any collection of facts 'fixed in any tangible medium of expression' will by necessity have a closing date" (footnote omitted)).

• As proof of its creativity in electing to parallel-cite to *United States Reports*, *Supreme Court Reporter*, and *Lawyer's Edition*, West lists eight other reporters of Supreme Court opinions that do not parallel-cite to these sources, and to which West does not parallel-cite. But all of these reporters are *daily* or *weekly* updates intended to provide quick copies of the slip opinions, not to serve as research tools or permanent records, and they are not recognized as standard sources for citation in the legal profession. West's decision to omit parallel citation to those reporters requires no evaluative judgment, and the decision by the publishers of those reporters and services to omit parallel citation to the same reporters cited by West reflects the more limited purpose of those reporters rather than the creativity of West's own choice.[10]

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10. West maintains a list of 300 cases deemed by West to be so well known that West will leave intact one-party references to these cases without expanding the case citation. This practice involves an undeniably creative, but minor, insight into which cases are within an ordinary lawyer's frame of reference, and the expression of that

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> In the end, West decided to include *every* permanent record of Supreme Court opinions — *i.e.*, it makes no "selection" at all.
>
> • Nor do we see any creativity in West's decision to cite to official state reporters as well as regional NRS reporters for state court decisions. These are almost always the only two realistic choices (again, this hardly amounts to "selection"), and a decision to cite to an official reporter can hardly be said to be anything other than typical.[11]

One useful way to appreciate how little creativity inheres in West's citation decisions is to consider what West's

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selection would be protectable. Nevertheless, West offered no evidence as to how often these cases are cited without a full citation in the judicial opinions that HyperLaw seeks to copy and we will not find infringement for what seems to be *de minimis* copying of protected material. *Cf. Warner Bros. Inc. v. American Broad. Cos.*, 720 F.2d 231, 242 (2d Cir. 1983) (noting that *de minimis* rule permits "the literal copying of a small and usually insignificant portion of the plaintiff's work").

11. West emphasizes that *The Bluebook*'s rule dispenses with citation to official reporters, but it ignores another *Bluebook* rule that practitioners cite to official state reporters for cases decided by the state in which the practitioner is filing papers. *See The Bluebook*, *supra*, rule P.3. Furthermore, another citation guide recommends citing to both the official reporter and the NRS reporter on all occasions. *See The University of Chicago Manual of Legal Citation* 15 (1989) ("When citing to a state case, indicate the volume and first page of the case for both the official and commercial reporters.").

competitors would have to do to avoid an infringement claim were we to find West's citation decisions copyrightable. Competitors such as HyperLaw seeking to create a useful case report would need to engage in their own original selection of parallel and alternate citations. But while some generally useful information which does not appear in West's case reports could be included (such as citations to LEXIS instead of Westlaw), most of the information a researcher would find useful (such as citations to West NRS reporters) already have been added to West's case reports; West gives few examples of other useful supplementary information. A competitor that included these alterations, notwithstanding their inclusion in West's case reports, could have no confidence that an infringement claim could be avoided, especially given our warning in *Key Publications* that infringement cannot be avoided by pointing to isolated differences from a copyrighted work. *See Key Publications, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991) (holding that a compilation copyright is not so "thin" as to be "anorexic," and does not allow "subsequent compilers to avoid infringement suits simply by adding a single fact to a verbatim copy of the copyrighted compilation, or omitting in the copy a single fact contained in the copyrighted compilation"). One way of saying that West's "choices" are obvious and typical is that a competitor would have difficulty creating a useful case report without using many of the same citations. Affording these decisions copyright protection could give West an effective monopoly over the commercial publication of case reports (at least those containing supplemental citations).

Nor do we think the district court erred in concluding that the combination of these citation decisions is

unprotectable. West's particular decisions about which parallel citations to insert are driven in each instance by the court's decision to cite to a certain case, and thus each editorial choice is independent of the others. The cumulative effect of these citation decisions is a piling up of things that are essentially obvious or trivial (albeit helpful), each in its discrete way in its discrete spot. The whole does not disclose or express an overall creative insight or purpose, such as a set of statistics that together allow the ranking of a group of ball players, or a designation or highlighting of phone numbers that together allow the user of a phone book to enjoy an unusual or particular convenience. The combined effect of West's non-creative citation decisions cannot be said to be creative, on such a theory or any other theory that West advances. We conclude that the district court did not clearly err in deciding that West's citation alterations display insufficient creativity to be protectable.

* * *

Finally, West's overall decision to add attorney information, subsequent history, and additional citation information exhibits little, if any, creative insight; most courts already provide attorney information, and opinion accuracy mandates inclusion of subsequent history.

West's editorial work entails considerable scholarly labor and care, and is of distinct usefulness to legal practitioners. Unfortunately for West, however, creativity in the task of creating a useful case report can only proceed in a narrow groove. Doubtless, that is because for West or any other editor of judicial opinions for legal research, faithfulness to the

public-domain original is the dominant editorial value, so that the creative is the enemy of the true.[12]

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12. HyperLaw argues that we should apply the merger doctrine to bar the copyrightability of West's alterations to judicial opinions.

> The fundamental copyright principle that only the expression of an idea and not the idea itself is protectable has produced a corollary maxim that even expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself.

Kregos v. Associated Press, 937 F.2d 700, 705 (2d Cir. 1991) (citation omitted). HyperLaw claims that the idea of a case report has effectively merged with West's expression of that concept.

We decline to invoke the merger doctrine in this case. First, "[o]ur Circuit has considered this so-called 'merger' doctrine in determining whether actionable infringement has occurred, rather than whether a copyright is valid." *Id.*; *see also CCC Info. Servs., Inc. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 72 n.26 (2d Cir. 1994) ("In this circuit, consideration of the merger doctrine takes place in light of the alleged copying to determine if infringement has occurred, rather than in analyzing the copyrightability of the original work."). In addition, under this approach, "if a defendant has actually copied the plaintiff's work, it is unlikely to be allowed to rely on merger to avoid liability," *Kregos*, 937 F.2d at 716 (Sweet, *J.*, concurring in part and dissenting in part). HyperLaw seeks a declaratory judgment holding West's case reports non-copyrightable and allowing it actually to copy West's case reports. It therefore cannot avail itself of the merger doctrine.

Second, West's work does not constitute a "building block[] of understanding," which we have indicated is the type of expression to which we will consider applying the merger doctrine. *See CCC Info. Servs.*, 44 F.3d at 71.

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Our decision in this case does not mean that an editor seeking to create the most accurate edition of another work never exercises creativity.[13] As West argues, our decisions establish a low threshold of creativity, even in works involving selection from among facts. But those cases involved the exercise of judgments more evaluative and creative than West exercises in the four elements of the case reports that HyperLaw intends to copy. For instance, in *Kregos* thousands of different permutations of pitching statistics were available for inclusion in the publisher's pitching chart. *See Kregos*, 937 F.2d at 704; *see also Eckes*

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13. It is true that some types of editing require little creativity. *See, e.g., Grove Press, Inc. v. Collectors Publication, Inc.*, 264 F. Supp. 603, 605 (C.D. Cal. 1967) ("Plaintiff made approximately forty thousand changes from the Verlag copy in producing its edition. These changes consisted almost entirely of elimination and addition of punctuation, changes of spelling of certain words, elimination and addition of quotation marks, and correction of typographical errors. These changes required no skill beyond that of a [1967] high school English student and displayed no originality. These changes are found to be trivial."). In addition, convention and external forces may, as here, limit the practical choices available so as to eliminate any creativity.

On the other hand, preparing an edition from multiple prior editions, or creating an accurate version of the missing parts of an ancient document by using conjecture to determine the probable content of the document may take a high amount of creativity. *See, e.g.*, Abraham Rabinovich, *Scholar: Reconstruction of Dead Sea Scroll Pirated*, Wash. Times: Nat'l Wkly. Edition, Apr. 12, 1998, at 26 (discussing scholar's copyright infringement claim in Israeli Supreme Court relating to his reconstruction of the missing parts of a "Dead Sea Scroll" through the use of "educated guesswork" based on knowledge of the sect that authored work).

v. Card Prices Update, 736 F.2d 859, 863 (2d Cir. 1984) (baseball card guide which selected 5,000 "premium" baseball cards from among 18,000 eligible baseball cards was copyrightable). In *Key Publications*, we found sufficient creativity because the author of the yellow pages "excluded from the directory those businesses she did not think would remain open for very long." 945 F.2d at 513. In *CCC Information Services*, we found sufficient creativity in the selection of optional car features and number of years' models to be included in a used-car price compilation. 44 F.3d at 67. And in *Lipton v. Nature Co.*, 71 F.3d 464 (2d Cir. 1995), the author "selected [the terms included in the work] from numerous variations of hundreds of available terms." *Id.* at 470. In each of these cases, the compiler selected from among numerous choices, exercising subjective judgments relating to taste and value that were not obvious and that were not dictated by industry convention. *See Mid America Title Co. v. Kirk*, 59 F.3d 719, 723 (7th Cir. 1995) (distinguishing cases involving exercise of subjective judgment).[14]

Similarly, in *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir. 1989), a textual derivative-work case, we found sufficient creativity where the author of the derivative work had drawn on earlier joint works with another professor to create a document that contained the following new elements from the previous version of the document:

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14. HyperLaw argues also that West has failed to comply with the requirement of 17 U.S.C. § 403 that it identify those parts of the government work in which it does not claim a copyright. Because we find that the elements of West's case reports that HyperLaw seeks to copy are not protectable, we need not reach this issue.

> (1) a selection and arrangement of photo illustrations and associated captions; (2) references to recent reports in the pertinent literature; (3) selection, condensation, and description of additional source material; (4) several new textual additions; (5) substantial rearrangement of the manner and order of presentation of material contained in the parties' prior joint works; and (6) the addition of a section on "congenital disorders," a revised treatment of "chronic cholecystitis," and the incorporation of Dr. Freeman's "false positive" studies.

Id. at 1322. As this passage demonstrates, the alterations inserted in the derivative work were by no means obvious or driven by professional convention, and resulted in substantial changes to the substance and flow of the piece. No such substantial variations characterize West's case reports.

CONCLUSION

The district court did not clearly err in concluding that the elements of West's case reports that HyperLaw seeks to copy are not copyrightable. The judgment of the district court is affirmed.

Appendix A

Matthew Bender & Co. and Hyperlaw, Inc. v. West Publishing Co.

97-7910

Sweet, D.J.

The key issue in this appeal is whether West's *Supreme Court Reporter* and *Federal Reporter* case reports in the context of its overall reporter citation system meet the constitutional and statutory requirement of creative originality. Because the majority imposes a standard that demands significantly more than the "modicum" of originality required by *Feist Publications, Inc., v. Rural Telephone Service Company, Inc.*, 499 U.S. 340 (1991), and far more than the "non-trivial" variation required by this Court for derivative-work and compilation copyright protection, I respectfully dissent.[1]

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1. Although not dispositive since I believe that the district court's determination is clearly erroneous, review should be *de novo*. Whether West's annotations are copyrightable requires application of the legal standard imposed by the constitution and copyright statute to the undisputed facts. To the extent prior Second Circuit opinions have reviewed issues of copyrightability for clear error, they appear inconsistent with the Supreme Court's *de novo* review of a similar issue in *Feist* (impliedly, although not expressly, reversing district court after *de novo* review), inconsistent with the *de novo* standard applied by this Court in other mixed questions in copyright law, *see e.g. American Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 918 (2d Cir. 1995) (fair use is mixed question subject to *de novo* review); *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 85 (2d Cir. 1995) (work for hire status legal conclusion reviewed *de novo*, although factual

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Appendix A

The Copyright Act protects both derivative works and compilations, and I agree with the majority that West's case reports have elements of both. The standard for copyrightability set forth in *Feist*, as the majority notes, is applicable whether West's editorial work is analyzed in terms of derivative work or compilation. *See e.g., Atari Games Corp. v. Oman*, 979 F.2d 242, 244-45 (D.C. Cir. 1992) (*Feist* applicable to [audio-visual] compilation); 2 W. Patry, *Copyright Law and Practice* 1225 (1994) (*Feist* applicable to derivative works). Contrary to the majority's holding, however, I find that West's selection and arrangement of factual annotations to public domain judicial opinions, considered as a whole, is copyrightable.

Originality alone — whether the "author make[s] the selection or arrangement independently (i.e. without copying that selection or arrangement from another work)" — is not sufficient. *Feist*, 499 U.S. at 358. The work must also "display some minimal level of creativity." *Id.* Creativity for copyright purposes is not a philosophical question: the "creative spark" need only pass "the narrowest and most obvious limits." *See Bleistein v. Donaldson Lithographing Company*, 188 U.S. 239, 260. The "modicum of creativity" requires simply that

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finding of each relevant factor reviewed for clear error); *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 766 (2d Cir. 1991) (substantial similarity reviewed *de novo* since credibility not at issue), or distinguishable, *see Financial Information, Inc. v. Moody's Investors Service, Inc.*, 808 F.2d 204, (2d Cir. 1986) (noting that district court relied "on its evaluation of the credibility of witnesses — which we are ill-disposed to disturb on appeal" whereas here facts are not in dispute).

the author prove "the existence of . . . intellectual production, of thought, and conception." *Feist*, 499 U.S. at 362 (quoting *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59-60 (1884)); *see also Key Publications Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509, 514 (2d Cir. 1991). ("*[D]e minimis* thought withstands originality requirement").

Thus, while the majority is correct that it is "not a goal of copyright law" to encourage the creation of compilations which lack "sufficient creativity," it is well-established that the required level of creativity is "extremely low." *Feist*, 499 U.S. at 345.[2]

In *Feist*, Rural's alphabetical arrangement by surname, and selection of name, town and telephone number to include in a telephone book, was "practically inevitable." *Id.* at 363. Although the facts need not be presented in an "innovative or surprising way," Rural's choice was "so mechanical or routine as to require no creativity whatsoever." *Feist*, 499 U.S. at 362. Indeed, the copyright claimant in *Feist* had no real choice how to arrange a white pages directory, particularly given that state law prescribed the selection of data, and that only a few basic decisions were involved. *Id.* Also significant was that only Rural possessed the underlying data. *Id.* at 363.

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2. Indeed, "[m]ost applications of *Feist* have recognized the circumscribed sphere to which its holding applies, ruling that it invalidates the copyright only in the most banal of works, such as the white pages of a phone book." 1. M. Nimmer, *Copyright* § 3.04[B][2], p.3-33 (footnotes omitted).

Here, West has made choices to make its reporters and its citation system valuable. West makes dozens of multi-part, variable judgments, and there is no evidence that any of West's choices are commonplace, "practically inevitable," dictated by law, or that they follow any external guidelines. On the contrary, the record demonstrates that West makes a number of substantive, editorial choices — without court direction or approval — in determining the content and expression of its case reports. West's judgments involve assessments of "readability," clarity, completeness, availability (present and future) of sources, and other subjective considerations related to making the reports more useful.

Specifically, West asserts that originality inheres in the following aspects of its editorial process: (1) its decisions about when to add parallel citations and which parallel citations to add; (2) its substitution of "alternative citations" when its editors deem that the original citation should be improved upon in terms of usefulness, currency, or accuracy; (3) its addition of its own citations when none are provided; (4) its internal revision and correction of citations; (5) its expansion and completion of citation page references; (6) its creation, selection, and arrangement of additional text to reflect subsequent case developments; (7) its selection and arrangement of data for attorney summaries, and (8) its revision and reorganization of captions, court lines, date lines, and other prefatory material. Because these choices express thought and are not inevitable, West's annotations do not fall in the "narrow category" of works which are not copyrightable.

The fact that federal judges publish written opinions differently than West is sufficient reason to conclude that West's version requires some "thought" and is sufficiently "creative" to satisfy the modicum necessary for copyrightability. If a federal judge chooses to cite only to the United States Reporter, include minimal attorney information in his or her written opinion, or not provide a cite for a referenced case, then an alternative choice to provide parallel citations, expand attorney information, and cite the case cannot be deemed so "typical," "garden-variety," "obvious" or "inevitable" to prohibit copyrightability. *Cf. Feist*, 499 U.S. at 362-63.

The majority dissects each element of West's editorial process and then extrapolates that "the cumulative effect of these citation decisions is a piling up of things that are essentially obvious or trivial (albeit helpful), each in its discrete way in its discrete spot."

West's originality, however, cannot be determined by the sum total of whatever (creativity) remains after each individual component is atomized. Indeed, this Court recently warned against the dangers of basing copyrightability analysis on an approach which isolates each element or ignores the "protectible expression within an unprotectible element." *Softel, Inc. v. Dragon Medical and Scientific Communications, Inc.*, 118 F.3d 955, 964 (2d Cir. 1997). *See also* 3 M. Nimmer, *Copyright* § 13.03 [F][5], at 13-145 n.345.1 (explaining that the fact that Hamlet's soliloquy can be reduced into unprotectible words does not mean that the soliloquy as a whole lacks originality for copyright purposes).

West's selection of particular annotations for each case must be considered a whole, not individually. *See Key Publications*, 945 F.2d at 514 (issue is "whether the arrangement . . . viewed in the aggregate, is original"). In defining a derivative work, the issue is whether "modifications" "represent an original work of authorship" must be considered "*as a whole*." 17 U.S.C. § 101 (emphasis added) (definition of derivative work). The same legislative command is repeated in the definition of compilations, which provides that a compilation is "a work formed by the collection and assembling of preexisting materials . . . that are selected, coordinated, or arranged in such a way that the resulting work *as a whole* constitutes an original work of authorship." 17 U.S.C. § 101 (emphasis added). The cumulative and collective originality manifest in West's case reports satisfies the "*de minimis*" level needed for the work as a whole to be copyrightable. Indeed, it must be assumed that the originality and the consequent utility of the West citation system is precisely the reason that Hyperlaw seeks to use West as its verbatim source.

In my view the decision of the majority is not consistent with the post-*Feist* case *Key Publications*, 945 F.2d 509. In *Key Publications*, this Court held that classified directories of Chinese-American businesses was copyrightable because, among other things, plaintiff excluded enterprises she believed would not remain in business. This selection "indicates thought and creativity in the selection of businesses included." *Id.* at 513. If there is a modicum of originality in deciding which businesses are likely to stay open for awhile, the test is surely also met by deciding in a system designed to assist legal research for example, which sources are

sufficiently useful, available, or permanent to stand alone, and which require the addition of an electronic parallel citation.

Contrary to the majority's view, the alternative factual annotations selected by West are not comparable to the cases where courts have denied copyright protection based on lack of originality. In *Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc.*, 936 F.2d 671 (2d Cir. 1991), it was undisputed that the publisher's selection and arrangement of fact categories was exactly the same as that of all racing-chart publishers. *Id.* at 672. In *Financial Information, Inc. v. Moody's Investors Service, Inc.*, 808 F.2d 204 (8th Cir. 1986), *cert. denied*, 484 U.S. 820, it was beyond dispute that the five basic facts listed on the Daily Bond Cards were an "inevitable" choice devoid of originality. In this case, by contrast, all of West's basic choices involve subjective judgment.

In *Skinder-Straus Associates v. Massachusetts Continuing Legal Education, Inc.*, 914 F. Supp. 665 (D. Mass 1995), the court held that the legal directory *is copyrightable* "as a whole," and therefore the question was substantial similarity, not copyrightability. *Id.* at 677. Although the *Skinder-Straus* court held that individual elements, such as a calendar of Christian and Jewish holidays, were not copyrightable, here West does not seek copyrightability of individual facts, but rather seeks to prevent verbatim copying of the case report as a whole.

The copyright granted West is thin, but it is sufficient to protect against the verbatim digital copying proposed by

Hyperlaw. This result protects the advancement of science and the arts, while not permitting Hyperlaw to undermine any incentive for West to annotate judicial opinions selectively. If West's competitors were authorized to scan West's editorial enhancements systematically and, in effect, to copy its citation system, the economic incentive to engage in this kind of original and productive enterprise would largely evaporate.

There is no danger here that granting West's copyright protection to its annotations provides them a monopoly over the "idea" of publishing judicial opinions. When the number of ways data can be organized is so limited that its expression merges with the idea, copyright may be denied. However, here "there are a sufficient number of ways of expressing the idea . . . to preclude a ruling that the idea has merged into its expression." *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991). In *Kregos*, this Court held that "the past performances of baseball pitchers can be measured by a variety of statistics," and is copyrightable. Here, too, opinions can be, and are, written with a variety of citation combinations and other facts either included or not. This case is not like *Matthew Bender & Co. v. Kluwer Law Book Publishers, Inc.*, 672 F. Supp. 107 (S.D.N.Y. 1987), where the court concluded that the categories in the plaintiff's chart (amount, case, plaintiff event, injury, and relevant data) are "the only sensible ones which could have been used to compile the data." *Id.* at 112.

To the extent that the West selection of factual annotation may seem obvious to anyone familiar with legal sources, it

may be because of West's success in the market.[3] There is no support for the proposition that West's success in achieving an "industry standard" citation arrangement obligates them to donate the material to the public domain. *Cf. BellSouth*, 999 F.2d at 1444 (industry standard copied from industry association).

For the reasons stated, I conclude the summary judgment granted in favor of Hyperlaw should be reversed.

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3. The contention that all of West's enhancements are trivial is somewhat ironic given that what motivates this litigation, it is assumed, is the desire to make money by copying West's valuable editorial work.

APPENDIX B — MEMORANDUM OPINION AND ORDER OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK DATED MAY 19, 1997

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

94 Civ. 0589

MATTHEW BENDER & COMPANY, INC.,

Plaintiff,

–v.–

WEST PUBLISHING COMPANY,

Defendant.

HYPERLAW, INC.,

Intervenor-Plaintiff,

–v.–

WEST PUBLISHING COMPANY,

Defendant.

MEMORANDUM OPINION AND ORDER

Appendix B

JOHN S. MARTIN, Jr., District Judge:

This action raises the question of the extent of the copyright protection available to West Publishing Company with respect to the opinions of the United States Supreme Court and the Circuit Courts of Appeals that it publishes in the Supreme Court Reporter and the Federal Reporter Series.

There is no question that West invests substantial time in reviewing each opinion, checking the citations, adding parallel citations, modifying the caption to conform to its style and adding information concerning the attorneys involved and subsequent history of the case.[1] The issue presented here is whether the changes West makes to an opinion, either singly or in combination, represent a sufficient creative effort to warrant copyright protection.

BACKGROUND

In this case the plaintiff, Hyperlaw, Inc., is the publisher of CD-ROM products, one of which contains recent Supreme Court cases, and the other, recent Circuit Court of Appeals cases. Although Hyperlaw obtains the text of most of the current cases from sources other than West, in a small percentage of cases it scans the title, texts and certain other information directly from the West reports. It does not, however, scan the headnotes that West adds to its reports or the key numbers it inserts in the opinions.

---

1. West also prepares headnotes which digest the issues decided. There is no claim in this case that West is not entitled to copyright protection with respect to headnotes.

In addition, Hyperlaw intends to expand its products so that a user reviewing an opinion can see the full text of any case cited in the opinion by simply clicking on the citation. Since many of the cited cases are from before 1990 when Hyperlaw began collecting the cases, it intends to scan these cases into its product directly from the West Reporters. Alan Sugarman, Hyperlaw's President, admitted that this process of obtaining cited cases might ultimately result in Hyperlaw scanning up to 75% of West cases into its system.[2]

DISCUSSION

The determination of the legal issues presented involve the balancing of competing policy considerations. Since as children we all had drilled into our heads the maxim: "Thou shall not copy," it seems fundamentally unfair to allow Hyperlaw to take advantage of the substantial time and expense West has invested in its reporters by engaging in wide-ranging copying of the opinions published by West. On the other hand, the opinions published by West are written, not by West, but by federal judges and it seems unfair to say that West can preclude anyone from copying what is basically a government document.

Since the extent of copyright protection varies depending on the nature of the copyrighted work, i.e. greater protection exists for original works than is available for compilations or derivative works, the first issue the Court must address is

---

2. West raises issues with respect to justiciability, which, in the end rest on its objection to Mr. Sugarman's testimony at trial. The decision to permit this testimony was argued at trial and will not be revisited here.

the nature of the copyright protection at issue. *Feist Publications, Inc. v. Rural Telephone Serv. Comp., Inc.*, 499 U.S. 340, 348-49, 111 S. Ct. 1282, 1289 (1991).

West contends that it has a copyright in the compilation of the reporters and, therefore, the legality of plaintiff's conduct must be judged by the standards that apply to compilations. Hyperlaw argues that it is not copying the order of cases used by West or its indices, but only individual opinions, and that the extent of West's protectible interest in any single opinion must be determined under the standards that apply to derivative works.

The Court agrees that the correct analysis is that which applies to derivative works. The fact that Hyperlaw scans hundreds of cases rather than a single case does not mean that it is copying "those aspects of the compilation that embody the original creation of the compiler." *CCC Info. Serv., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 66 (2d Cir. 1994). West's compilation copyright protects its arrangement of cases, its indices, its headnotes and its selection of cases for publication, but these are not what Hyperlaw is copying. What Hyperlaw is copying is the individual reported decision and the fact that it copies one, two or a thousand decisions does not change the fact that it is the decisions and not West's compilation of those decisions that Hyperlaw is copying.

Section 101 of the Copyright Act defines a derivative work as a "work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship. . . ." 17 U.S.C.

§ 101. Thus, in its most simple form, the question presented is whether each reported decision found in the West reports is an original work of West authorship.

The Second Circuit recently reviewed the standards to be applied to determine whether a derivative work is entitled to copyright protection in *Woods v. Bourne Co.*, 60 F.3d 978, 990 (2d Cir. 1995) stating:

> In order for a work to qualify as a derivative work it must be independently copyrightable. . . . (citations omitted). The basis for copyright protection contained in both the constitution and the Copyright Act is originality of authorship. . . . (citations omitted).
>
> We thoroughly discussed the standard of originality in a derivative work in our in banc decision in Batlin. There we held that "there must be at least some substantial variation [from the underlying work], not merely a trivial variation." (quoting *L. Batlin & Son, Inc. v Snyder*, 536 F.2d 486, 491 (2d Cir.) (in banc), *cert. denied*, 429 U.S. 857, 97 S. Ct. 156 (1976)).

The changes that West makes to an opinion that it publishes do not make the reported decision "independently copyrightable." If one looks at each opinion as a whole then it seems clear that the changes made by West are trivial indeed. Minor changes to the caption, the identification of judges and information as to the attorneys, together with the insertion of subsequent history are not sufficient to qualify

West's reprints as "original works of authorship." 17 U.S.C. § 102(a).

What West endeavors to do here is to ignore the work as a whole and look at each individual change and argue that it changes substantially that particular piece of information. For example, West argues that it makes a substantial change to the cases cited in an opinion when it adds a parallel citation. Even if this were a substantial change to that citation, it is still trivial change to the court's opinion.

In order to determine whether the opinions, as reported in West, are entitled to copyright protection, it is necessary to look at the significance of each individual change only for the purpose of determining whether the totality of the changes made by West can be said to constitute "an original work of authorship."

The first change that West makes to a court opinion is in the title of the case. West will capitalize those names or portions thereof that will be used in citing the case, sometimes abbreviate portions of the parties' names, sometimes combine captions when two or more cases are reported together and make other minor changes to ensure that a consistent form is used in all reported decisions. It is hard to characterize the changes made in the title as involving creative activity. Rather, they are simply a mechanical application of preexisting rules of citation. While West rules may vary somewhat from *A Uniform System of Citation*, which is generally used throughout the legal community, the differences do not appear to be of major significance. The case names are facts reported by the courts and West's

modifications thereto are not significant enough to give it a protectible interest in the case title. As Judge Leisure observed in his thorough and well-reasoned opinion in *Hearn v. Meyer*, 664 F.Supp. 832, 847 (S.D.N.Y. 1987):

> It is well understood that authors wishing to express ideas within the context of factual background often can choose from only a limited number of terms. Copyright protection is afforded rarely where a fact permits only a narrow continuum or spectrum of expression.

West lists with the case title, the docket number and the date argued and decided. These are clearly facts and even though West must make some effort to obtain some of this information, there is nothing so original about West's expression of these facts that would entitle them to copyright protection. *Feist*, 499 U.S. at 350-51, 111 S. Ct. at 1290. As the Supreme Court noted in *Feist*, "raw facts may be copied at will. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art." *Id.* at 350; 111 S. Ct. at 1290.

West adds to the title a "file line" that will give subsequent history, such as "rehearing denied" and the date of the action. In most instances these are straightforward factual summaries of court action and the choice of methods of expressing these developments is generally limited and subject to widely accepted rules of citation.

A more substantial question is presented by the decisions that West makes with respect to subsequent opinions issued

by the court in the same case that either correct or modify the earlier opinion. In such instances West must make a judgment whether to combine the two opinions, publish them separately or simply make the correction in the final bound volume. Here again the options are limited and the decision does not involve any creative effort which would transform West's report of the decision into an original work by West.

West next claims a protectible interest in its publication of the names of the attorneys. While in many cases it takes some effort for West to gather the names and to identify the city where the defendant practices, these are facts which West cannot copyright. *Feist*, 499 U.S. at 360, 111 S. Ct. at 1295; *Financial Information v. Moody's Investors Serv.*, 808 F.2d 204, 208 (2d Cir. 1986) (copyrightability is "not determined by the amount of effort the author expends, but rather by the nature of the final result."). While West clearly makes an editorial judgment as to which attorneys' names to publish and whether to add the city of practice, there are only a limited number of choices to be made. Certainly West could not prevent a competitor who was not copying West's opinions from using the identical method for reporting the names of the attorneys involved in the case. *Hearn v. Meyer*, 664 F. Supp. at 847. While Hyperlaw's blatant copying of this material may offend one's sense of basic fairness, it does not mean that West has an interest in the attorneys' names that the copyright laws were designed to protect.

West may make some changes in the presentation of the names of the judges involved in the decision but these changes are clearly trivial.

Appendix B

West makes two types of changes within the text of the opinions: corrections and additions. West cite checkers carefully review each decision and correct any misspellings or errors in either the form or the substance of the citations. In some instances the court will be called to determine whether there is an error in the opinion. While West clearly expends considerable time and money on this effort and performs a valuable service to the bench and the bar, there is no element of creativity or originality involved in these corrections.

There are two types of additions that West makes to the opinions. One involves the filling in of blanks, such as a reference back to a portion of the same opinion or a blank left in a citation because the official reporter in which the cited case appears had not been printed at the time the original decision was filed. This mechanical search for and addition of facts is clearly not protected by copyright. *Feist*, 499 U.S. at 362, 111 S. Ct. at 1296.

The most significant additions that West makes to the opinions that it reports are its inclusion of parallel citations and its changes to citations to cite to a more readily available source. In most instances the determination of which parallel citations to include are basically mechanical and reflect no level of originality. Here again the selections made tend to conform to the standard of the legal profession and appear consistent with those recommended in *A Uniform System of Citation*. Surely the decision to cite to a bound volume rather than an advance sheet or a computerized source does not reflect even a modicum of originality. Nor do the limited number of instances in which West makes a judgment as to

which of a number of equally accessible sources should be cited give to its case reports a sufficient level of originality to invoke the protection of the Copyright Act.

In sum, each of the changes that West makes to the cases it reports are trivial and, taken separately or collectively, they do not result in "a distinguishable variation" of the opinion written by the court. *Waldman Publishing Corp. v. Landoll, Inc.*, 43 F.3d 775, 782 (1994).

Since the Court has determined that West does not have a protectible interest in any of the portions of the opinions that Hyperlaw copies or intends to copy, there is no need to reach the question of whether West's copyright notice complies with the requirements of Section 403 of the Copyright Act or whether Hyperlaw would be entitled to a defense of fair use. Indeed, since this Court cannot predict which elements of the case reports published by West the Second Circuit might find entitled to protection, a fair use analysis cannot be done.

The Court would note, however, that there does appear to be an interplay between section 403 and the fair use analysis. As the Court noted at an earlier stage in this litigation, in deciding the question of fair use, "[a]nalysis begins not by elevating the statutory guides to inflexible rules, but with a review of the underlying equities." *Weissmann v. Freeman*, 868 F.2d 1313, 1323 (2d Cir. 1989). Section 403 clearly reflects a judgment by Congress that those who publish material that basically comes from government sources should not be able to appropriate that material for themselves simply by incorporating additional material into

the text without giving adequate notice to the public of that portion of the document that contains material protected by the publishers' copyright. Thus, in doing a fair use analysis with respect to any reprint of an opinion published by West, it would be reasonable to weigh against West the fact that it does nothing to indicate to the public which portions of the reprinted opinions contain new matter added by West as to which they claim a copyright.

CONCLUSION

Since West has no copyright interest in those elements of the reported opinions which Hyperlaw is copying and intends to copy, Hyperlaw is entitled to a judgment that its copying on the opinions from the West reports does not violate West's copyrights.

The foregoing shall constitute the Court's findings of fact and conclusions of law.

SO ORDERED.

Dated: New York, New York
May 19, 1997

s/ John S. Martin, Jr.
JOHN S. MARTIN, JR., U.S.D.J.

APPENDIX C — JUDGMENT OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK DATED JUNE 30, 1997

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

94 CIV 0589 (JSM)

MATTHEW BENDER & COMPANY, INC.,

Plaintiff,

– against –

WEST PUBLISHING COMPANY, and WEST PUBLISHING CORPORATION,

Defendant.

HYPERLAW, INC.,

Intervenor-Plaintiff,

– against –

WEST PUBLISHING COMPANY and WEST PUBLISHING CORPORATION,

Defendant.

JUDGMENT

This action came on for trial before the Court, Honorable John S. Martin, Jr., presiding, and the issues having been duly tried and a decision having been rendered,

Appendix C

It is Ordered and Adjudged

1. That changes made by West in its Supreme Court Reporter and Federal Reporter Series to the text of judicial opinions do not represent a sufficient creative effort to warrant copyright protection, either singly or in combination, as elements of a derivative work, a compilation, or otherwise.

2. That since West has no copyright interest in those elements of the reported decisions which HyperLaw is copying and intends to copy, HyperLaw may copy opinions from West's Supreme Court Reporter and Federal Reporter Series without violating the copyright law.

3. This judgment does not pertain to the syllabi, synopses, headnotes and key numbers within West's reporters, as those items were not before the Court in this cause.

Dated: New York, New York
June 30, 1997

s/ John S. Martin, Jr.
JOHN S. MARTIN, JR., U.S.D.J.

APPENDIX D — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT DENYING PETITION FOR REHEARING DATED AND FILED DECEMBER 22, 1998

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT
UNITED STATES COURT HOUSE
40 FOLEY SQUARE
NEW YORK 10007

CAROLYN CLARK CAMPBELL
CLERK

At a stated term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse, Foley Square, in the City of New York, on the **22nd** day of **December** one thousand nine hundred and ninety-**eight.**

Dkt No: 97-7910

Matthew Bender

Plaintiff

v

West Publishing Co.

Defendant-Appellant.

A petition for rehearing en banc having been filed herein by the appellant West Publishing Co. and West Publishing Corporation.

Appendix D

Upon consideration by the panel that decided the appeal, it is Ordered that said petition for rehearing is **DENIED.**

It is further noted that the petition for rehearing en banc has been transmitted to the judges for the court in regular active service and to any other judge that heard the appeal and that no judge has requested that a vote be taken thereon.

FOR THE COURT

CAROLYN CLARK CAMPBELL,
Clerk

By: s/ Beth J. Meador
Beth J. Meador,
Administrative Attorney

APPENDIX E — JUDGMENT OF THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT DATED NOVEMBER 3, 1998 AND FILED NOVEMBER 4, 1998

SDNY/NYNY
94-cv-589
Judge Martin

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT
UNITED STATES COURT HOUSE
40 FOLEY SQUARE
NEW YORK 10007

At a stated Term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse in the City of New York, Foley Square, on the 3rd day of November, one thousand nine hundred and ninety-eight.

BEFORE: Hon. Richard J. Cardamone
Hon. Dennis Jacobs
Circuit Judges
Hon. Robert W. Sweet
District Judge*

Docket No. 97-7910

MATTHEW BENDER & COMPANY, INC.,

Plaintiff,

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* The Honorable Robert W. Sweet, of the United States District Court for the Southern District of New York, sitting by designation.

Appendix E

HYPERLAW, INC.,

Intervenor-Plaintiff-Appellee,

–v–

WEST PUBLISHING CO.; WEST PUBLISHING CORPORATION,

Defendants-Appellants.

Appeal from the United States District Court for the Southern District of New York.

This cause came on to be heard on the transcript of record from the Southern District of New York and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now hereby **ORDERED, ADJUDGED, and DECREED** that the judgment of said district court be and it hereby is affirmed in accordance with the opinion of this court.

FOR THE COURT
Carolyn Clark Campbell, Clerk
By:

s/ Beth J. Meador
Beth J. Meador
Administrative Attorney

MOTION FILED
APR 16 1999

(2)

No. 98-1519

In The
Supreme Court of the United States

October Term, 1998

WEST PUBLISHING CO. and
WEST PUBLISHING CORP.,

Petitioners,

v.

HYPERLAW, INC.,

Respondent.

ON PETITION FOR WRIT OF *CERTIORARI*
TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

MOTION FOR PERMISSION TO FILE *AMICUS CURIAE* OPPOSITION TO PETITION FOR *CERTIORARI* and OPPOSITION TO PETITION FOR *CERTIORARI* BY *AMICUS CURIAE* MALLA POLLACK, SUPPORTING RESPONDENT

Malla Pollack, Esq., Associate Prof. of Law
Florida Coastal School of Law
7555 Beach Blvd.; Jacksonville, FL 32216
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(email) mpollack@fcsl.edu
Amicus Curiae Filing Pro-Se

14pp

MOTION FOR PERMISSION TO FILE *AMICUS* OPPOSITION TO PETITION FOR *CERTIORARI*

Malla Pollack ("Pollack") respectfully moves this Court for permission to file the attached *Opposition to the Petition for Certiorari* in No. 98-1519, *West Publishing Co. and West Publishing Corp. v. Hyperlaw, Inc.* Pollack supports Respondent, Hyperlaw, Inc. Pollack has received permission to file from Carl J. Hartman, counsel for Hyperlaw, Inc. James F. Rittinger (Satterlee Stephens Burke & Burke LLP), Counsel for Petitioners, has refused permission on the sole ground that my "request does not identify what relevant matter [my] opposition would bring to the attention of the Court." (Facsimile letter from Rittinger to Pollack of April 8, 1999 at 1).

INTEREST OF THE *AMICUS CURIAE*

Amicus curiae Pollack wishes to submit the attached *Opposition to Petition for Certiorari* solely to help protect the beleaguered public domain. *Cf.* David Lange, *Recognizing the Public Domain*, 44 (No. 4) Law & Contemp. Probs. 147, 176 (1981) (suggesting that in intellectual property cases the courts should "solicit and welcome amicus participation" or appoint *guardians ad litem* for the public domain). Pollack is an Associate Professor of Law who has authored articles on the interaction of the Intellectual Property Clause of the United States Constitution, U.S. Const., Art. I, sec. 8, cl. 8, with other constitutional provisions. *See* Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 Cardozo Arts & Ent. L.J. 47

(1999); Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of* Shakespeare Co. v. Silstar Corp., 18 Seattle U. L. Rev. 259 (1995).

ARGUMENT
REASONS TO GRANT PERMISSION

Pollack respectfully submits that the attached brief "brings to the attention of the Court relevant material" that is not likely to be addressed fully by the parties. Sup. Ct. R. 37.1.

Petitioners raise only statutory issues. Pollack wishes to alert this Court to the constitutional dimensions of this case.

Petitioners argue the economic importance of the Court's helping business persons in Petitioners' industry. Pollack wishes to alert this Court to Congress' already on-going investigation of Petitioners' economic assertions.

Petitioners and Respondents are all businesses that wish to earn revenue from legal publishing. Pollack volunteers to act as unpaid spokesperson for the general public's interest in its public domain.

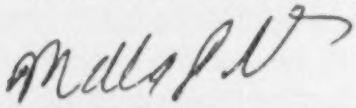
Pollack respectfully claims some slight expertise as she has just published an article concerning the issues not discussed in West Publishing Co. and West Publishing Corp.'s Petition for Certiorari. *See* Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and*

the First Amendment, 17 Cardozo Arts & Ent. L.J. 47 (1999).

CONCLUSION

For all the reasons discussed above, Pollack respectfully requests this Court to allow her to file the attached *pro se Opposition to Petition for Certiorari by Amicus Curiae Malla Pollack*, supporting Respondent.

Respectfully submitted April 16, 1999



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OPPOSITION TO PETITION FOR CERTIORARI

INTEREST OF THE *AMICUS CURIAE*

Amicus curiae Malla Pollack ("Pollack")[1] submits this brief solely to help protect the beleaguered public domain. *Cf.* David Lange, *Recognizing the Public Domain*, 44 (No. 4) Law & Contemp. Probs. 147, 176 (1981) (suggesting that in intellectual property cases the courts should "solicit and welcome amicus participation" or appoint *guardians ad litem* for the public domain). Pollack is an Associate Professor of Law who has authored articles on the interaction of the Intellectual Property Clause of the United States Constitution, U.S. Const., Art. I, sec. 8, cl. 8, with other constitutional provisions. *See* Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 Cardozo Arts & Ent. L.J. 47 (1999) (hereinafter "*Right to Know*"); Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of* Shakespeare Co. v. Silstar Corp., 18 Seattle U. L. Rev. 259 (1995).

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1 No part of this brief was authored in whole or in part by counsel for any party. Malla Pollack is paying the cost of preparation, printing, and submission of her *amicus* filings personally and from the Professional Development Fund provided by her employer, Florida Coastal School of Law, 7555 Beach Blvd., Jacksonville, FL 32216.

SUMMARY OF ARGUMENT

The Court should deny the petitions for *certiorari* filed by West Publishing Co. and West Publishing Corp. ("the Petitioners") in both No. 98-1500 and No. 98-1519 (collectively "West's Cases").[2] Petitioners raise only issues under the Copyright Act, 17 U.S.C. §§ 101 *et. seq.*, as construed by *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). The central issues in both of West's Cases, however, are the interrelationships among the Intellectual Property Clause, U.S. Const. art. I, § 8, cl. 8, the Commerce Clause, U.S. Const. art. I, § 8, cl. 3, and the First Amendment, U.S. Const. amend. I. Petitioners have not, however, posed these constitutional questions in their petitions for *certiorari*. Any Supreme Court opinion in this case, no matter how narrowly drafted, would risk generating further confusion on constitutional matters.

Congress, furthermore, is currently considering both Petitioners' market concerns and the constitutional issues related to Commerce Clause protection of writings. Judicial economy and inter-branch comity counsel waiting for Congress to finish. At the minimum, Congress will clarify the factual background. At the maximum, Congress will render the legal issues obsolete.

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2 Pollack has filed substantively identical *amicus* papers in both cases.

ARGUMENT

A. *Certiorari* Is Inappropriate Because This Case Does Not Proffer For Decision The Central Constitutional Issues Involved

West Publishing Co. and West Publishing Corp. ("Petitioners") pose only questions regarding the Copyright Act, 17 U.S.C. §§ 101 *et. seq.*, as construed since *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). *See* West Publishing Co. and West Publishing Corp.'s Petition for Certiorari at i (Questions Presented). *Feist*, however, targeted the constitutional limits imposed upon the Copyright Act by the Intellectual Property Clause of the United States Constitution. U.S. Const. art. I, § 8, cl. 8 ("Congress shall have the power . . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."). *See, e.g., Feist*, 499 U.S. at 344 ("Originality is a constitutional requirement"); *id.* at 351 ("As we have explained, originality is a constitutionally mandated prerequisite for copyright protection."); *id.* at 363 ("As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimus* quantum of creativity.").

Feist dropped conflicting hints about additional Commerce Clause protection for sweat works (such as the parties' publications).

Additional protection might be supported by *Feist*'s dictum that:

> [p]rotection for the fruits of such [factual] research . . . may in certain circumstances be available under a theory of unfair competition. [Even though] to accord copyright protection on this basis alone distorts basic copyright principles . . . .

Id. at 354. This dictum, however, may be read differently. "[U]nfair competition," *Feist*, 499 U.S. at 354 (O'Connor, J.), is rooted in the "common law of deceit" and concerned only with "protecting consumers from confusion." *See Bonito Boats v. Thundercraft Boats*, 489 U.S. 141, 157 (1989) (O'Connor, J.).

Feist, furthermore, undercuts additional protection by pronouncing that misappropriation, the basis of the Court's decision in *International News Serv. v. Associated Press*, 248 U.S. 215 (1918), is "not relevant" to massive copying from a sweat work. *Feist*, 499 U.S. at 354 n.(unnumbered). *See The Right to Know*, *surpa*, 17 Cardozo Arts & Ent. L.J. at 76-77.

After *Feist*, the important disputed territory lies at the intersection between the Intellectual Property Clause and the Commerce Clause. The Court has never mapped this intersection, but the Court has fenced the similar junction between the Commerce Clause, U.S. Const. art. I, § 8, cl. 3, and the Bankruptcy Clause, U.S. Const. art. I, § 8, cl. 4. ("The Congress shall have power . . . To establish . . . uniform Laws on the subject of Bankruptcies throughout the United States."). The Court restrained Congress from using the Commerce Clause to circumvent the Bankruptcy Clause's uniformity requirement. *See Railway Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 471 (1982)(statute intended to help one specific bankrupt railroad is beyond Congress'

power). *Railway Labor* suggests that the Commerce Clause may not be used to bypass textual limits in the Intellectual Property Clause. Commentators, however, differ on the borders of *Railway Labor*. *Compare, e.g., Right to Know, supra*, 17 Cardozo Arts & Ent. L.J. at 61 (after *Railway Labor* and *Feist*, a sweat work "protection act grounded on the Commerce Clause can pass constitutional scrutiny only if the act is carefully limited to situations of market failure.") *with* Jane Ginsberg, *No "Sweat"? Copyright and Other Protection of Works of Information After* Feist v. Rural Telephone, 92 Colum. L. Rev. 338, 370-71 (1992)(After *Railway Labor* and *Feist*, "Congress might have power to enact a misappropriation statute under the Commerce Clause if the statute set forth a scheme of protection quantitatively different from a copyright regime.")

The junction between the Intellectual Property and Commerce Clauses is both sufficiently important and sufficiently dark to warrant Supreme Court illumination in an appropriate case. This, however, is not an appropriate case. Petitioners have not posed constitutional questions.

Because the competing books and CD-ROM products at issue transmit legal opinions to the public, West's Cases carry judicial scrutiny toward an additional constitutional intersection — the crossroads between the Intellectual Property Clause and the First Amendment (Speech, Press, and Petition Clauses). This constitutional junction is also both important and largely unmapped.

Re importance, as James Madison famously pronounced "[k]nowledge will forever govern ignorance" and "[a] popular government without popular information [] or the means of acquiring it is but a prologue to a farce or a

tragedy or perhaps both." Letter from James Madison to W.T. Berry (Aug. 4, 1822), *in* James Madison, *The Complete Madison* 337 (Saul K. Padover ed., 1953).

Re uncertain topography, the First Amendment/Intellectual Property Clause interchange is largely unilluminated. True, this Court pronounced that

> copyright's idea/expression dichotomy strikes a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression.

Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 556 (1985). Since the copier in *Harper & Row* lost, however, *id.* at 542, the quoted statement is merely dictum. This Court has never held an intellectual property right unconstitutional on the ground that the First Amendment requires the idea/expression dichotomy. *See Right to Know*, *supra*, 17 Cardozo Arts & Ent. L.J. at 68-69 nn.106-12. The text of the Constitution, furthermore, does not announce a right to know.

Again, the constitutional area is worth this Court's exploration in an appropriate case. Again, this is not an appropriate case. Petitioners have not posed constitutional questions.

If the Court grants *certiorari* to the Petitioners, the Court unnecessarily[3] risks compounding constitutional

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3 As discussed *infra*, Section II, Petitioners have nonjudicial recourse. Congress is considering whether producers of sweat works need increased legal protection. Petitioners

confusion. Petitioners' and Respondent's works are the type of sweat works addressed in *Feist*. Any opinion by this Court, therefore, will be scrutinized for its clarification of the constitutional issues raised, but not resolved, in *Feist*. The Court, however, cannot use Petitioners' cases to properly address these important constitutional issues for the simple reason that Petitioners have not asked the right questions — at trial, on appeal, or in their petitions for *certiorari*.

B. *Certiorari* Is Inappropriate Because Congress Is Already Considering The Economic And Constitutional Issues Central To This Case

Petitioners rely on the alleged economic importance of this case. Petitioners argue that numerous, publicly beneficial sweat works will not be created or marketed absent Court action. *See, e.g.*, West Publishing Co. and West Publishing Corp.'s Petition for Writ of Certiorari at 6, 15, 22, 23, & 26. Petitioners should (and already have) addressed their economic arguments to Congress.

Congress is considering whether database protection legislation is warranted to close the alleged "protection gap" created by *Feist*. *See, e.g., Hearings on H.R. 354, "Collections of Information Anti-piracy Act" before the House Judiciary Subcommittee on Courts and Intellectual Property*, 106th Cong. 2 (March 18, 1999)(hereinafter "March 1999 Hearings")(statement of Marybeth Peters, Register of Copyrights) (*Feist* motivated consideration of a database protection statute) <http:// www.house.gov/ judiciary/ 106-pete.htm> (visited March 18, 1999); 145 Cong. Rec. S316 (daily ed. Jan. 19, 1999)(remarks of

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have submitted testimony to Congress. *See infra* at 8-9.

Senator Orrin Hatch)(same); *see also Right to Know, supra,* 17 Cardozo Arts & Ent. L.J. 58 n.62 (collecting references to *Feist* as Congress' motivation for considering database legislation).

Congress has already invested substantial resources in collecting relevant information and opinions. The 104th Congress considered The Database Investment and Intellectual Property Antipiracy Act, H.R. 3531. *See* 143 Cong. Rec. E890-91 (daily ed. May 23, 1996)(introductory statement by Hon. Carlos J. Moorehead). The House of Representatives, 105th Congress, passed two slightly different versions of The Collections of Information Anti-piracy Act. *See* H.R. 2652 (passed May 19, 1998), 144 Cong. Rec. H73398-404 (daily ed. May 19, 1998); H.R. 2652 (passed Aug. 4, 1998), 144 Cong. Rec. H7074-104 (daily ed. Aug. 4, 1998). The Senate, 105th Congress, considered, but did not vote on, a companion bill, S. 2291. *See* 144 Cong. Rec. 7959 (daily ed. July 10, 1998)(bill read twice and referred to the Committee on the Judiciary). Three different database bills have already been suggested to the Senate, 106th Congress. *See* 145 Cong. Rec. S316-26 (daily ed. Jan, 19, 1999)(remarks of Senator Orrin Hatch). The House, 106th Congress, has already held hearings on H.R. 354, The [revised] Collections of Information Anti-piracy Act. <http:// www.house.gov/ judiciary/ 031799.htm> (visited March 18, 1999) (written testimony from March 18, 1999 hearings before House Judiciary Subcomm. on Courts and Intellectual Property).

Petitioners have offered testimony on the currently pending H.R. 354 through two witnesses. *See* March 1999 Hearings, *supra,* (statement of Ms. Marilyn Winokur on behalf of the *ad hoc* Coalition Against Database Piracy,

which includes West's owner, The Thompson Corp., at 4); *id.* (statement of Daniel C. Duncan on behalf of the Software Information Industry Ass'n, which includes West's owner, The Thompson Corp., at 3).

Despite Petitioners' plaint, the economic case for additional protection is not clear. Even the economic expert hired by a pro-protection industry group went no farther than urging Congress to "consider how fast the industry might have grown with statutory protection;" but as she admitted "[t]he database industry has grown rapidly, driven by new technologies. Since 1979, the number of databases on the market has grown nearly 10-fold." *Hearings on the "Collections of Information Antipiracy Act" Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary*, 105th Cong. 2 (Oct. 1997) (statement of Laura D'Andrea Tyson and Edward F. Sherry, paid consultants for the Information Industry Ass'n). In the aftermath of *Feist*, between 1991 and 1997, (i) the number of databases increased from 7637 to 10338, i.e. 35%, and (ii) the number of files in databases increased from 4 billion to 11.2 billion, i.e. 180%. *See Hearings on the "Collections of Information Antipiracy Act" Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary*, 105th Cong. 4 (Feb. 1998) (statement of Jonathan Band, Online Banking Ass'n, opposing legislation).

Economists are split on whether the absence of legal protection for intellectual property would generate under-production or over-production of information products, such as Petitioners'. *See* James Boyle, *A Politics of Intellectual Property: Environmentalism for the Net?*, 47 Duke L.J. 87, 98 (1997)(collecting economic authorities).

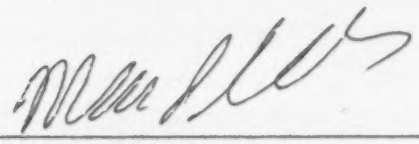
Judicial economy counsels waiting for Congress to finish studying the complexities of information markets. At the minimum, Congress will clarify the factual background. At the maximum, Congress will render the legal issues obsolete.

Judicial comity with a co-equal branch of government also counsels this Court to wait for Congress' views on the constitutional issues before revisiting *Feist*. *See, e.g.*, Ruth Bader Ginsberg, *Speaking In A Judicial Voice*, 67 N.Y.U. L. Rev. 1185, 1198 (1992)(Judges "participate in a dialog with other organs of government, and with the people as well"; "[m]easured motions seem to me right, in the main, for constitutional as well as comon law adjudication. Doctrinal limbs too swiftly shaped, experience teaches, may prove unstable.")(footnotes omitted). Congress is aware of the constitutional dimensions of granting protection to sweat works. *See, e.g.*, March 1999 Hearings ("the Administration's concerns . . . include the concern that the Constitution imposes significant constraints upon Congress' power to enact legislation of this sort.")(statement of Andrew J. Pincus, U.S. Dep't of Commerce, at 3). The congressional inquiry, furthermore, may trigger learned discussion of the constitutional issues; such discussion may ease this Court's path through a later presented and more appropriate case.

CONCLUSION

For all the reasons discussed above, this Court should deny Petitioners' request for *certiorari*.

Respectfully submitted April 16, 1999



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